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**UNITED STATES DISTRICT COURT**  
**FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

AMERANTH, INC.,  
Plaintiff,  
vs.  
GRUBHUB, INC.  
Defendant.

Case No. 3:12-cv-00739-JLS-NLS

**DEFENDANT GRUBHUB, INC.'S FIRST  
AMENDED ANSWER TO PLAINTIFF'S  
FIRST AMENDED COMPLAINT FOR  
INFRINGEMENT**

**TRIAL BY JURY DEMANDED**

Complaint Filed: March 27, 2012

Defendant GrubHub, Inc. ("GrubHub") hereby answers Plaintiff Ameranth, Inc.'s ("Ameranth") First Amended Complaint for Patent Infringement ("Complaint"). Like paragraph numbers are used for reference purposes.

**PARTIES**

1. GrubHub admits that Ameranth is a Delaware corporation but is without current knowledge or information sufficient to form a belief as to the truth of the remaining

allegations of Paragraph 1 of the Complaint, and therefore denies the same.

2. GrubHub admits that is a Delaware corporation and that its principal place of business is Chicago, Illinois. GrubHub denies the remaining allegations of the Paragraph 2 of the Complaint.

### **JURISDICTION AND VENUE**

3. GrubHub admits that the Complaint purports to be an action for patent infringement arising under 35 U.S.C. §§ 271, 281-285.
4. GrubHub admits the allegations of paragraph 4 of the complaint.
5. GrubHub admits that it operates a restaurant service that can be used by residents of this Judicial District. GrubHub denies the remaining allegations of paragraph 5 of the Complaint.
6. GrubHub admits that the Court has personal jurisdiction over it. GrubHub denies the remaining allegations of paragraph 6 of the Complaint.
7. GrubHub admits that Venue is proper in this Judicial District. GrubHub denies the remaining allegations of paragraph 7 of the Complaint.

### **BACKGROUND**

8. GrubHub is without current knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 8 of the Complaint, and therefore denies the same.
9. GrubHub is without current knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 9 of the Complaint, and therefore denies the same.
10. GrubHub is without current knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 10 of the Complaint, and therefore denies the same.
11. GrubHub is without current knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 11 of the Complaint, and therefore denies the same.

### **RELATED CASE PREVIOUSLY FILED**

12. GrubHub admits that U.S. Pat. No. 8,146,077 is related to U.S. Pat. Nos. 6,384,850, 6,871,325, and 6,982,733. GrubHub denies the remaining allegations of paragraph 12 of the Complaint.

1 13. GrubHub admits that Ameranth is the plaintiff and counter-defendant in Case No. 3:11-  
2 cv-018180-JLS-NLS, and that GrubHub is a defendant and counter-plaintiff in that case.  
3 GrubHub denies the remaining allegations of paragraph 13 of the Complaint.

4 **COUNT I**

5 14. GrubHub reiterates and incorporates its responses to paragraphs 1-13 above as if fully set  
6 forth herein.

7 15. GrubHub admits United States Patent No. 8,146,077 (the '077 patent") indicates on its  
8 face that it issued on March 27, 2012, and that the '077 patent is entitled "Information  
9 Management and Synchronous Communications System with Menu Generation."  
10 GrubHub admits that a copy of the '077 patent was attached to the Complaint. GrubHub  
11 denies the remaining allegations of paragraph 15 of the Complaint.

12 16. GrubHub is without current knowledge or information sufficient to form a belief as to the  
13 truth of the remaining allegations of paragraph 16 of the Complaint, and therefore denies  
14 the same.

15 17. GrubHub denies the allegations of paragraph 17 of the Complaint.

16 18. GrubHub denies the allegations of paragraph 18 of the Complaint.

17 19. GrubHub denies the allegations of paragraph 19 of the Complaint.

18 20. GrubHub denies the allegations of paragraph 20 of the Complaint.

19 21. GrubHub denies the allegations of paragraph 21 of the Complaint.

20 22. GrubHub denies the allegations of paragraph 22 of the Complaint.

21 23. GrubHub denies the allegations of paragraph 23 of the Complaint.

22 24. GrubHub denies the allegations of paragraph 24 of the Complaint.

23 25. GrubHub denies the allegations of paragraph 25 of the Complaint.

24 26. GrubHub denies the allegations of paragraph 26 of the Complaint.

25 **PRAYER FOR RELIEF**

26 27. GrubHub denies that Ameranth is entitled to any of the requested relief.

27 28. To the extent not expressly admitted above, GrubHub denies the factual allegations of the  
28 Complaint.

**DEMAND FOR JURY TRIAL**

29. GrubHub admits that Ameranth has demanded a jury trial.

**AFFIRMATIVE DEFENSES**

**First Affirmative Defense**

30. GrubHub does not infringe any valid and enforceable claim of the '077 patent.

31. For example, claims 1-12 of the '077 patent require "[a]n information management and real time synchronous communications system for configuring and transmitting hospitality menus".

32. GrubHub does not make, use, sell, or offer for sale an "ordering system/product/service" that includes "[a]n information management and real time synchronous communications system for configuring and transmitting hospitality menus".

33. For example, claims 1-8 of the '077 patent require "menu configuration software enabled to generate a programmed handheld menu configuration from said master menu for wireless transmission to and programmed for display on a wireless handheld computing device, said programmed handheld menu configuration comprising at least menu categories, menu items and modifiers and wherein the menu configuration software is enabled to generate said programmed handheld menu configuration by utilizing parameters from the master menu file structure defining at least the menu categories, menu items and modifiers of the master menu such that at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information comprising the master menu".

34. GrubHub does not make, use, sell or offer for sale an "ordering system/product/service" that includes "menu configuration software enabled to generate a programmed handheld menu configuration from said master menu for wireless transmission to and programmed for display on a wireless handheld computing device, said programmed handheld menu configuration comprising at least menu categories, menu items and modifiers and wherein the menu configuration software is enabled to generate said programmed handheld menu configuration by utilizing parameters from the master menu file structure defining at least

1 the menu categories, menu items and modifiers of the master menu such that at least the  
2 menu categories, menu items and modifiers comprising the programmed handheld menu  
3 configuration are synchronized in real time with analogous information comprising the  
4 master menu”.

5 35. For example, claims 9-12 of the ‘077 patent require “a modifier menu capable of being  
6 stored on said data storage device, and menu configuration software enabled to  
7 automatically generate a programmed handheld menu configuration from said master  
8 menu for display on a wireless handheld computing device, said programmed handheld  
9 menu configuration comprising at least menu categories, menu items and modifiers and  
10 wherein the menu configuration software is enabled to generate said programmed  
11 handheld menu configuration by utilizing parameters from the master menu file structure  
12 defining at least the categories and items of the master menu and modifiers from the  
13 modifier menu at least the menu categories, menu items and modifiers comprising the  
14 programmed handheld menu configuration are synchronized in real time with analogous  
15 information comprising the master and modifier menus”.

16 36. GrubHub does not make, use, sell or offer for sale an “ordering system/product/service”  
17 that includes “a modifier menu capable of being stored on said data storage device, and  
18 menu configuration software enabled to automatically generate a programmed handheld  
19 menu configuration from said master menu for display on a wireless handheld computing  
20 device, said programmed handheld menu configuration comprising at least menu  
21 categories, menu items and modifiers and wherein the menu configuration software is  
22 enabled to generate said programmed handheld menu configuration by utilizing  
23 parameters from the master menu file structure defining at least the categories and items  
24 of the master menu and modifiers from the modifier menu at least the menu categories,  
25 menu items and modifiers comprising the programmed handheld menu configuration are  
26 synchronized in real time with analogous information comprising the master and modifier  
27 menus”.

28 37. For example, claims 1-12 of the ‘077 patent require “wherein the menu configuration

1 software is further enabled to generate the programmed handheld menu configuration in  
2 conformity with a customized display layout unique to the wireless handheld computing  
3 device to facilitate user operations with and display of the programmed handheld menu  
4 configuration on the display screen of a handheld graphical user interface integral with the  
5 wireless handheld computing device, wherein said customized display layout is  
6 compatible with the displayable size of the handheld graphical user interface”.

7 38. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
8 that includes “wherein the menu configuration software is further enabled to generate the  
9 programmed handheld menu configuration in conformity with a customized display layout  
10 unique to the wireless handheld computing device to facilitate user operations with and  
11 display of the programmed handheld menu configuration on the display screen of a  
12 handheld graphical user interface integral with the wireless handheld computing device,  
13 wherein said customized display layout is compatible with the displayable size of the  
14 handheld graphical user interface”.

15 39. For example, claims 1-8 require “wherein the programmed handheld menu configuration  
16 is configured by the menu configuration software for display as programmed cascaded  
17 sets of linked graphical user interface screens appropriate for the customized display  
18 layout of the wireless handheld computing device, wherein said programmed cascaded  
19 sets of linked graphical user interface screens for display of the handheld menu  
20 configuration are configured differently from the cascaded sets of linked graphical user  
21 interface screens for display of the master menu on said first graphical user interface”.

22 40. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
23 that includes “wherein the programmed handheld menu configuration is configured by the  
24 menu configuration software for display as programmed cascaded sets of linked graphical  
25 user interface screens appropriate for the customized display layout of the wireless  
26 handheld computing device, wherein said programmed cascaded sets of linked graphical  
27 user interface screens for display of the handheld menu configuration are configured  
28 differently from the cascaded sets of linked graphical user interface screens for display of

1 the master menu on said first graphical user interface”.

2 41. For example, claims 9-12 of the ‘077 patent require “wherein the programmed handheld  
3 menu configuration is configured by the menu configuration software for display as  
4 cascaded sets of linked graphical user interface screens appropriate for the customized  
5 display layout of the wireless handheld computing device, wherein said cascaded sets of  
6 linked graphical user interface screens for display of the programmed handheld menu  
7 configuration are configured differently from the cascaded sets of related graphical user  
8 interface screens for display of the master menu on said first graphical user interface”.

9 42. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
10 that includes “wherein the programmed handheld menu configuration is configured by the  
11 menu configuration software for display as cascaded sets of linked graphical user interface  
12 screens appropriate for the customized display layout of the wireless handheld computing  
13 device, wherein said cascaded sets of linked graphical user interface screens for display of  
14 the programmed handheld menu configuration are configured differently from the  
15 cascaded sets of related graphical user interface screens for display of the master menu on  
16 said first graphical user interface”.

17 43. For example, claims 1-8 of the ‘077 patent require “wherein the system is enabled for real  
18 time synchronous communications to and from the wireless handheld computing device  
19 utilizing the programmed handheld menu configuration including the capability of real  
20 time synchronous transmission of the programmed handheld menu configuration to the  
21 wireless handheld computing device and real time synchronous transmissions of  
22 selections made from the handheld menu configuration on the wireless handheld  
23 computing device”.

24 44. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
25 that includes “wherein the system is enabled for real time synchronous communications to  
26 and from the wireless handheld computing device utilizing the programmed handheld  
27 menu configuration including the capability of real time synchronous transmission of the  
28 programmed handheld menu configuration to the wireless handheld computing device and

1 real time synchronous transmissions of selections made from the handheld menu  
2 configuration on the wireless handheld computing device”.

3 45. For example, claims 9-12 of the ‘077 patent require “wherein the system is enabled for  
4 real time synchronous communications to and from the wireless handheld computing  
5 device utilizing the programmed handheld menu configuration including the capability of  
6 real time synchronous transmission of at least the menu categories, menu items and  
7 modifiers comprising the programmed handheld menu configuration to the wireless  
8 handheld computing device and real time synchronous transmissions of selections made  
9 from the handheld menu configuration on the wireless handheld computing device”.

10 46. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
11 that includes “wherein the system is enabled for real time synchronous communications to  
12 and from the wireless handheld computing device utilizing the programmed handheld  
13 menu configuration including the capability of real time synchronous transmission of at  
14 least the menu categories, menu items and modifiers comprising the programmed  
15 handheld menu configuration to the wireless handheld computing device and real time  
16 synchronous transmissions of selections made from the handheld menu configuration on  
17 the wireless handheld computing device”.

18 47. For example, claims 1-12 of the ‘077 patent require “wherein the system is further enabled  
19 to automatically format the programmed handheld menu configuration for display as  
20 cascaded sets of linked graphical user interface screens appropriate for a customized  
21 display layout of at least two different wireless handheld computing device display sizes  
22 in the same connected system”.

23 48. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
24 that includes “wherein the system is further enabled to automatically format the  
25 programmed handheld menu configuration for display as cascaded sets of linked graphical  
26 user interface screens appropriate for a customized display layout of at least two different  
27 wireless handheld computing device display sizes in the same connected system”.

28 49. For example, claims 13-18 of the ‘077 patent require “[a]n information management and



1 real time synchronous communications system for use with wireless handheld computing  
2 devices and the internet comprising”.

3 50. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
4 that includes “[a]n information management and real time synchronous communications  
5 system for use with wireless handheld computing devices and the internet comprising”.

6 51. For example, claims 13-18 of the ‘077 patent require “real time communications control  
7 software enabled to link and synchronize hospitality application information  
8 simultaneously between the master database, wireless handheld computing device, web  
9 server and web page”.

10 52. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
11 that includes “real time communications control software enabled to link and synchronize  
12 hospitality application information simultaneously between the master database, wireless  
13 handheld computing device, web server and web page”.

14 53. For example, claims 13-18 of the ‘077 patent require “wherein the communications  
15 control software is enabled to utilize parameters from the master database file structure to  
16 synchronize the hospitality application information in real time between the master  
17 database, at least one wireless handheld computing device, at least one web server and at  
18 least one web page such that substantially the same information comprising the hospitality  
19 application information is capable of being displayed on the wireless handheld computing  
20 device, at least one web page and other display screens of the synchronized system, such  
21 that the hospitality application information is synchronized between any connected users”.

22 54. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
23 that includes “wherein the communications control software is enabled to utilize  
24 parameters from the master database file structure to synchronize the hospitality  
25 application information in real time between the master database, at least one wireless  
26 handheld computing device, at least one web server and at least one web page such that  
27 substantially the same information comprising the hospitality application information is  
28 capable of being displayed on the wireless handheld computing device, at least one web

1 page and other display screens of the synchronized system, such that the hospitality  
2 application information is synchronized between any connected users”.

3 55. For example, claims 13-18 of the ‘077 patent require “wherein the communications  
4 control software is enabled to act as a real time interface between the elements of the  
5 system and any applicable communications protocol”.

6 56. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
7 that includes “wherein the communications control software is enabled to act as a real  
8 time interface between the elements of the system and any applicable communications  
9 protocol”.

10 57. For example, claims 13-18 of the ‘077 patent require “wherein the communications  
11 control software is enabled to automatically and simultaneously configure the hospitality  
12 application information for display on both the wireless handheld computing device and  
13 the web page in conformity with a customized display layout unique to the wireless  
14 handheld computing device or the web page, wherein said customized display layout is  
15 compatible with the displayable size of the handheld computing device display screen or  
16 the web page”.

17 58. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
18 that includes “wherein the communications control software is enabled to automatically  
19 and simultaneously configure the hospitality application information for display on both  
20 the wireless handheld computing device and the web page in conformity with a  
21 customized display layout unique to the wireless handheld computing device or the web  
22 page, wherein said customized display layout is compatible with the displayable size of  
23 the handheld computing device display screen or the web page”.

24 59. For example, claims 13-18 of the ‘077 patent require “wherein the communications  
25 control software is further enabled to automatically format a programmed handheld  
26 configuration for display as cascaded sets of linked graphical user interface screens  
27 appropriate for a customized display layout of at least two different wireless handheld  
28 computing device display sizes in the same connected system”.

1 60. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
2 that includes “wherein the communications control software is further enabled to  
3 automatically format a programmed handheld configuration for display as cascaded sets of  
4 linked graphical user interface screens appropriate for a customized display layout of at  
5 least two different wireless handheld computing device display sizes in the same  
6 connected system”.

7 61. For example, claims 13-18 of the ‘077 patent require “wherein the system is enabled for  
8 real time synchronous transmission of the configured hospitality application information  
9 to the wireless handheld computing device, the web server and the web page and real time  
10 synchronous transmissions of inputs responding to the configured hospitality application  
11 information from the wireless handheld computing device, or the web server or the web  
12 page.”

13 62. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
14 that includes “wherein the system is enabled for real time synchronous transmission of the  
15 configured hospitality application information to the wireless handheld computing device,  
16 the web server and the web page and real time synchronous transmissions of inputs  
17 responding to the configured hospitality application information from the wireless  
18 handheld computing device, or the web server or the web page.”

19 63. GrubHub has not infringed and is not infringing, either literally or under the Doctrine of  
20 Equivalents, directly or indirectly, by inducement or contribution, any valid and  
21 enforceable claim of the ‘077 patent.

22 64. As GrubHub has not infringed and is not infringing any valid and enforceable claim of the  
23 ‘077 patent, GrubHub has not willfully infringed and is not willfully infringing any valid  
24 and enforceable claim of the ‘077 patent.

### 25 **Second Affirmative Defense**

26 65. The asserted claims of the ‘077 patent are taught in one or more single prior references  
27 and/or by a single prior art system, and are, therefore, invalid as anticipated.

28 66. For example, under the constructions that Ameranth is apparently taking in this case, each

1 and every element of the claims of the '077 patent are taught by U.S. Pat. No. 5,845,263  
2 ("Camaisa"), issued December 1, 1998, and titled Visual Ordering System. A true and  
3 correct copy of Camaisa is attached hereto as Exhibit A. Camaisa is prior art to the '077  
4 patent.

5 67. For example, under the constructions that Ameranth is apparently taking in this case, each  
6 and every element of the asserted claims of the '077 patent are taught by U.S. Pat. No.  
7 7,069,228 ("Rose"), issued June 27, 2006 and titled "Apparatus and Method for an  
8 Internet Based Computer Reservation Booking System". A true and correct copy of Rose  
9 is attached hereto as Exhibit B. Rose is prior art to the '077 patent.

10 68. Ameranth has accused Allmenus.com and Campusfood.com of infringing the '077 patent.

11 69. Allmenus.com and Campusfood.com use a common ordering system ("the Campusfood  
12 Ordering System").

13 70. The Campusfood Ordering System was designed and implemented prior to September 2,  
14 1997. On September 2, 1997, the Campusfood Ordering System took its first public  
15 orders, and it has been in continuous use since then. A brochure discussing the  
16 Campusfood Ordering System is attached as Exhibit C.

17 71. Under the constructions put forth by Ameranth in the First Menusoft Action, each and  
18 every element of the asserted claims of the '077 patent was present in the Campusfood  
19 Ordering System prior to the earliest priority date of the '077 patent.

20 72. Therefore, the claims of the '077 patent are invalid as anticipated under 35 U.S.C. § 102.

### 21 **Third Affirmative Defense**

22 73. The claims of the '077 patent are invalid as one of ordinary skill in the art would have  
23 found them obvious at the time of alleged invention. *See* 35 U.S.C. § 103.

24 74. The "TransPad" is prior art to the '077 patent. A true and correct copy of a publication  
25 describing the TransPad is attached hereto as Exhibit D.

26 75. The claims of the '077 patent would have been obvious to one of ordinary skill in the art,  
27 for example, through a combination of one or more of TransPad, Camaisa, Rose, the  
28 Campusfood Ordering System, or other prior art references.

1 76. Therefore, the asserted claims of the '077 patent are invalid as obvious under 35 U.S.C. §  
2 103.

#### 3 **Fourth Affirmative Defense**

4 77. The claims of the '077 patent are invalid as they have not complied with 35 U.S.C. § 112.

5 78. For example, the term "real-time" appears in the specification of the '077 patent in three  
6 places, outside of the claims: Col. 2, Line 27; Col. 5, Line 11; and Col. 12, Line 34. In  
7 each location that "real-time" is mentioned, it is within a sentence that reads similarly to  
8 the following: "Such features would include fast and automatic synchronization between  
9 a central database and multiple handheld devices, synchronization and communication  
10 between a World Wide Web ("Web") server and multiple handheld devices, a well-  
11 defined application program interface ("API") that enables third parties such as point of  
12 sale ("POS") companies, affinity program companies and internet content providers to  
13 fully integrate with computerized hospitality applications, real-time communication over  
14 the internet with direct connections or regular model dialup connections and support for  
15 batch processing that can be done periodically throughout the day to keep multiple sites in  
16 synch with the central database."

17 79. The specification of the '077 patent does not teach how real time synchronization of  
18 menus or some other hospitality information would be maintained between a wireless  
19 handheld device and a master menu or master database, which is required by all claims.

20 80. For example, claims 1-12 of the '077 patent require "[a]n information management and  
21 real time synchronous communications system for configuring and transmitting hospitality  
22 menus".

23 81. The written description of the '077 patent does not support "[a]n information management  
24 and real time synchronous communications system for configuring and transmitting  
25 hospitality menus".

26 82. The disclosure of the '077 patent taken as a whole does not enable a person of ordinary  
27 skill in the art to implement "[a]n information management and real time synchronous  
28 communications system for configuring and transmitting hospitality menus".

1 83. For example, claims 1-8 of the '077 patent require that "the menu configuration software  
2 is enabled to generate said programmed handheld menu configuration by utilizing  
3 parameters from the master menu file structure defining at least the menu categories,  
4 menu items and modifiers of the master menu such that at least the menu categories, menu  
5 items and modifiers comprising the programmed handheld menu configuration are  
6 synchronized in real time with analogous information comprising the master menu".

7 84. The written description of the '077 patent does not support "the menu configuration  
8 software is enabled to generate said programmed handheld menu configuration by  
9 utilizing parameters from the master menu file structure defining at least the menu  
10 categories, menu items and modifiers of the master menu such that at least the menu  
11 categories, menu items and modifiers comprising the programmed handheld menu  
12 configuration are synchronized in real time with analogous information comprising the  
13 master menu".

14 85. The disclosure of the '077 patent taken as a whole does not enable a person of ordinary  
15 skill in the art to implement "the menu configuration software is enabled to generate said  
16 programmed handheld menu configuration by utilizing parameters from the master menu  
17 file structure defining at least the menu categories, menu items and modifiers of the  
18 master menu such that at least the menu categories, menu items and modifiers comprising  
19 the programmed handheld menu configuration are synchronized in real time with  
20 analogous information comprising the master menu".

21 86. For example, claim 9-12 of the '077 patent require "the menu configuration software is  
22 enabled to generate said programmed handheld menu configuration by utilizing  
23 parameters from the master menu file structure defining at least the categories and items  
24 of the master menu and modifiers from the modifier menu at least the menu categories,  
25 menu items and modifiers comprising the programmed handheld menu configuration are  
26 synchronized in real time with analogous information comprising the master and modifier  
27 menus".

28 87. The written description of the '077 patent does not support "the menu configuration

1 software is enabled to generate said programmed handheld menu configuration by  
2 utilizing parameters from the master menu file structure defining at least the categories  
3 and items of the master menu and modifiers from the modifier menu at least the menu  
4 categories, menu items and modifiers comprising the programmed handheld menu  
5 configuration are synchronized in real time with analogous information comprising the  
6 master and modifier menus”.

7 88. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary  
8 skill in the art to implement “the menu configuration software is enabled to generate said  
9 programmed handheld menu configuration by utilizing parameters from the master menu  
10 file structure defining at least the categories and items of the master menu and modifiers  
11 from the modifier menu at least the menu categories, menu items and modifiers  
12 comprising the programmed handheld menu configuration are synchronized in real time  
13 with analogous information comprising the master and modifier menus”.

14 89. For example, claims 13-18 of the ‘077 patent require “[a]n information management and  
15 real time synchronous communications system for use with wireless handheld computing  
16 devices and the internet”.

17 90. The written description of the ‘077 patent does not support “[a]n information management  
18 and real time synchronous communications system for use with wireless handheld  
19 computing devices and the internet”.

20 91. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary  
21 skill in the art to implement “[a]n information management and real time synchronous  
22 communications system for use with wireless handheld computing devices and the  
23 internet”.

24 92. For example, claims 13-18 of the ‘077 patent require “real time communications software  
25 enabled to link and synchronize hospitality application information simultaneously  
26 between the master database, wireless handheld computing device, web server and web  
27 page”.

28 93. The written description of the ‘077 patent does not support “real time communications

software enabled to link and synchronize hospitality application information simultaneously between the master database, wireless handheld computing device, web server and web page”.

94. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary skill in the art to implement “real time communications software enabled to link and synchronize hospitality application information simultaneously between the master database, wireless handheld computing device, web server and web page”.

95. For example, claims 1-18 all require a “real time synchronous communications system”. A person of ordinary skill in the art would find the phrase “real time synchronous communications system” insolubly ambiguous, and therefore, all claims of the ‘077 patent are indefinite.

96. Therefore, all claims of the ‘077 patent are invalid for failing to comply with 35 U.S.C. § 112.

#### **Fifth Affirmative Defense**

97. Ameranth is estopped from construing a valid claim, if any should exist, of the ‘077 patent to be infringed literally or under the Doctrine of Equivalents due to admissions and/or statements made (a) to the U.S. Patent & Trademark Office during prosecution of the ‘077 patent or a related patent, (b) in the specification of the ‘077 patent or a related patent, (c) and/or during prior litigation of the ‘077 patent or a related patent.

#### **Sixth Affirmative Defense**

98. Ameranth’s claims for relief are barred by the doctrine of prosecution laches.

99. Ameranth filed U.S. Appl. No. 09/400,413, which matured into the ‘850 patent on September 21, 1999. Ameranth filed the immediate predecessor of the ‘077 patent, U.S. Appl. No. 10/016,517, as a continuation-in-part of U.S. Appl. No. 09/400,413 on November 1, 2001. U.S. Appl. No. 10/016,517 was the last application to add new matter to the line from which the ‘077 patent descends.

100. The claims that issued in the ‘077 patent were not first presented until February 2, 2012, or more than twelve (12) years after the filing of the ‘850 patent and more than ten (10)



1 years after Ameranth last added new matter to the line from which the '077 patent  
2 descends.

3 101. During those ten to twelve years, GrubHub was founded, developed a restaurant service  
4 that now includes menus from more than 250,000 restaurants, allows online ordering from  
5 nearly fifteen thousand (15,000) restaurants in more than three hundred (300) cities, and  
6 has helped millions of diners order food.

7 102. Ameranth's attempt to claim infringement of the '077 patent by GrubHub would  
8 prejudice GrubHub, which has expended significant effort and spent millions of dollars in  
9 developing its restaurant service and business during the ten to twelve years that  
10 Ameranth did not pursue the claims that matured into the '077 patent.

11 103. Accordingly, Ameranth is barred from seeking any relief for its claim of infringement of  
12 the '077 patent against GrubHub by the doctrine of prosecution laches.

13 **Seventh Affirmative Defense**

14 104. On information and belief, Ameranth's claims are barred by the doctrines of waiver,  
15 estoppel, and/or unclean hands.

16 **Eighth Affirmative Defense**

17 105. All claims of the '077 patent are unenforceable due to inequitable conduct during the  
18 prosecution of the '077 patent by Fabiano, who acted as prosecution counsel for Ameranth  
19 before the PTO, and Keith McNally ("McNally"), a named inventor and officer of  
20 Ameranth.

21 106. On February 2, 2010, McNally, who was then Chief Executive Officer of Ameranth,  
22 executed a power of attorney allowing Fabiano to represent Ameranth before the PTO  
23 within the prosecution of the '077 patent.

24 107. During the prosecution of the '077 patent McNally executed no fewer than four (4)  
25 declarations and participated in multiple interviews between Ameranth and the PTO.  
26 Accordingly, on information and belief, McNally was significantly involved in the  
27 prosecution of the '077 patent.

28 108. On information and belief, McNally stands to benefit financially from any licensing fees

1 or other revenue generated by the '077 patent.

2 109. Fabiano was retained by Ameranth to represent them in the prosecution of the '077 patent  
3 and the litigation of the '077 patent, and was significantly involved in the prosecution of  
4 the '077 patent. On information and belief, Fabiano stands to benefit financially from any  
5 licensing fees or other revenue generated by the '077 patent.

6 110. On February 2, 2012, Examiner Matthew Brophy ("Brophy") issued a notice of allowance  
7 after entering an earlier Examiner's amendment, Ameranth paid the issue fee on February  
8 6, 2012, and the '077 patent actually issued on March 27, 2012. Examiner Brophy  
9 primarily handled the examination of the '077 patent.

10 111. On July 26, 2005 U.S. Pat. Appl. 11/190,633 ("the '633 application") was filed on behalf  
11 of Ameranth as a continuation-in-part of the application that matured into the '077 patent.  
12 The specification of the '077 patent is substantially similar to that of the '633 application.

13 112. Examination of the '633 application has primarily been handled by Examiner Rutao Wu  
14 ("Wu").

15 113. In an office action mailed on January 7, 2010, Examiner Wu finally rejected all claims  
16 then pending of the '633 application as obvious over the combination of U.S. Pat. Nos.  
17 7,069,228 ("Rose") and 6,415,138 ("Sirola"). The January 7, 2010 office action is  
18 attached as Exhibit E. Sirola is attached hereto as Exhibit J.

19 114. Examiner Wu essentially argued that the web server of Rose served up hospitality  
20 information in accordance with the claimed elements, and that it would have been obvious  
21 to use the smart phone of Sirola to display the hospitality information served by Rose's  
22 web server using a web browser integrated into the smart phone. *See* Exh. E pp. 2-4, 6-7.

23 115. On information and belief, Fabiano or another attorney of Ameranth discussed the January  
24 7, 2010 final rejection with McNally and made him aware of the combination of Rose and  
25 Sirola.

26 116. On July 2, 2010, McNally, who was then President of Ameranth, executed a power of  
27 attorney allowing Fabiano to prosecute the '633 application. On the same day Fabiano  
28 filed a response to the rejection of all of Ameranth's claims then pending in the '633

1 application. The July 2, 2010 response added a claim element to claims 77 and 97 that  
2 required that hospitality information be displayed on “non PC standard display sizes”  
3 including display on the wireless handheld computing device. The July 2, 2010 response  
4 presented detailed arguments attempting to distinguish Ameranth’s alleged invention from  
5 Rose, Sirola, and the other cited art. Ameranth’s July 2, 2010 response is attached hereto  
6 as Exhibit F.

7 117. Despite Ameranth’s arguments, Examiner Wu continued to reject all of Ameranth’s  
8 claims in an office action dated October 5, 2010, which continued to rely on the  
9 combination of Rose and Sirola. All of Ameranth’s arguments were rejected by Examiner  
10 Wu in the October 5, 2010 office action, which is attached hereto as Exhibit G.

11 118. On October 26, 2010, Fabiano filed a response to the October 5, 2010 rejection. The  
12 October 26, 2010 response presented additional detailed arguments attempting to  
13 distinguish Ameranth’s alleged invention from Rose, Sirola and the other cited art.

14 119. On information and belief, on November 16, 2010 Fabiano held a telephonic interview  
15 with Examiner Wu during which Rose, Sirola, and other prior art references were  
16 discussed.

17 120. On December 8, 2010 Fabiano filed a supplemental response presenting additional  
18 arguments attempting to distinguish Ameranth’s alleged invention from Rose, Sirola and  
19 the other cited art.

20 121. On February 15, 2011 Examiner Wu issued a final rejection of all of pending claims of the  
21 ‘633 application. The February 15, 2011 rejection maintained Rose as the primary  
22 reference, and maintained the combination with Sirola. A new combination with U.S. Pat.  
23 No. 6,356,543 (“Hall”) was added as well. Hall is attached hereto as Exhibit K. In the  
24 February 15, 2011 rejection, which is attached hereto as Exhibit H, Examiner Wu set forth  
25 detailed rebuttals to Ameranth’s arguments. *See* Exh. H, pp. 3 – 13.

26 122. Ameranth appealed Examiner Wu’s Decision. Ameranth filed its Appeal Brief on March  
27 30, 2011. Examiner Wu filed an Examiner’s Answer on June 6, 2011, attached hereto as  
28 Exhibit I. Ameranth filed its reply brief on August 4, 2011. As of the date of this answer,

1 this appeal is still pending. None of the briefing of this appeal was submitted to the Patent  
2 Office with regards to the prosecution of the '077 patent.

3 123. Hall discloses a phone that can be used to download applications. It would have been  
4 obvious to a person of skill in the art at the time of the alleged invention to extend Hall to  
5 allow the download of an application allowing a web service interface with the web  
6 applications of Rose.

7 124. The reasons for allowance for the '077 patent reads as follows: "none of the prior art of  
8 record, alone or in reasonable combination, teach the limitations: wherein the system is  
9 further enabled to automatically format the programmed handheld menu configuration for  
10 display as cascaded sets of linked graphical user interface screens appropriate for a  
11 customized display layout of at least two different wireless handheld computing device  
12 display sizes in the same connected system, and wherein a cascaded set of linked  
13 graphical user interface screens for a wireless handheld computing device in the system  
14 includes a different number of user interface screens from at least one other wireless  
15 handheld computing device in the system. When combined with the other limitations of  
16 claim 103, 118 and 122. Specifically in these independent claims, the menu generation  
17 software and hospitality applications, in the context of the claimed system, which  
18 automatically create programmed handheld displayed as cascaded sets of graphical user  
19 interface screens for at least two different sizes and including at least two cascaded sets of  
20 GUIs with disparate screen counts in not found in the prior art as of the priority date  
21 September 21, 1999. No prior art of record, nor any combination [] teaches all limitations  
22 of the newly amended independent claims."

23 125. The combination of Rose, Sirola, and Hall speaks directly to the limitations that caused  
24 Examiner Brophy to issue the '077 patent. In particular, Rose discloses that it serves up  
25 hospitality content using a web server as a series of related hospitality web pages. *See*  
26 Exh. B, Figs. 5A – 22; Exh. H, pp. 2-13, 13-15; Exh I, pp. 4-5, 13-29. The content of  
27 Rose, can be displayed by any conventional web browser. *See* Exh. H, pp. 2-13, 13-15.  
28 Sirola and Hall both disclose wireless handheld computing devices that can be used to

display the web pages served by the web server of Rose. *See* Exh. J, 2:1-11, and Exh. K, Abstract. Both Sirola and Hall disclose separate wireless handheld computing devices that can be used to display hospitality information. *See* Exh. H, pp. 12-13, 15; Exh. J, Fig. 1; Exh. K, Fig. 1. Based on the individual screen sizes and resolutions of the phones of Sirola and Hall, the web pages will appear different from one another. *Compare* Exh. J, Fig. 1 *with* Exh. K, Fig. 1. Accordingly, the combination of Rose, Sirola, and Hall makes obvious the very limitations that Ameranth utilized to gain allowance. *See* Exh. H, pp. 3-5, 11-15; Exh. I, pp. 5-6, 16-21; *see especially* p. 19-20.

126. In fact, the combination of Rose, Sirola, and Hall makes obvious the entirety of at least claim 13 of the '077 patent. Accordingly, the '077 patent would not have issued if Fabiano and McNally had fulfilled their duty to disclose these references, as well as the Final Office Action of February 15, 2011 and the Examiner's Answer to Examiner Brophy.

127. The analysis of Examiner Wu, as embodied by the Final Office Action of February 15, 2011 (Exh. H), and the Examiner's Answer to Ameranth's Appeal Brief (Exh. I), shows Examiner Wu's detailed theory as to how to apply Rose, Sirola, and Hall to claims that are extremely similar to those that issued in the '077 patent. Examiner Wu's analysis of the claim elements of claims 77 and 97 requiring the display of hospitality data on "non PC standard display sizes" speaks directly to how Examiner Brophy could have applied Rose, Sirola, and Hall to reject at least claim 13 of the '077 patent.

128. The preamble of claim 13 requires "[a]n information management and real time synchronous communications system for use with wireless handheld computing devices and the internet comprising:". This limitation can be found in Rose (Exh. B) at the Abstract and 2:24-35.

129. Element 'a' of claim 13 requires "a master database connected in said system and configured to store hospitality application information pursuant to a master database file structure". This limitation is found in Rose (Exh. B) at Fig. 4, 6:44-55. Examiner Wu found the similar element "a master database containing at least one hospitality

- 1 application(s) and associated data” in Rose at 6:44-55; *see also* Exh. H, p. 14; Exh. I, p. 5.
- 2 130. Element ‘b’ of claim 13 requires “at least one wireless handheld computing device
- 3 connected in said system and configured to display said hospitality application
- 4 information”. The combination of Rose and Sirola discloses this limitation. *See* Rose
- 5 (Exh. B), Figs. 5A-22, 7:23-25; Sirola (Exh. J), Fig. 1, 2:1-21. Examiner Wu found that
- 6 the combination of Rose and Sirola discloses “application software enabled to configure
- 7 hospitality data for display on the ‘non pc standard’ display sized screen of at least one
- 8 wireless handheld computing device in which the at least one hospitality application is
- 9 stored”. In particular, Examiner Wu found that Rose disclosed “application software
- 10 enabled to configure hospitality data for display on at least one web page” at Figs. 5A-22
- 11 and 7:23-25, and that Sirola discloses a smart phone device (which is a wireless handheld
- 12 computing device with non pc standard display) that is capable of displaying web data at
- 13 2:1-21. *See* Exh. H, pp. 14-15, and Exh. I, pp. 5-6.
- 14 131. Element ‘c’ of claim 13 requires “at least one web server connected in said system”. Rose
- 15 (Exh. B) discloses this limitation at Fig. 3, 6:60-64. Examiner Wu found that Rose (Exh.
- 16 B) discloses “at least one web server enabled to interface with at least one hospitality
- 17 applications and its associated data” at 6:60-64. *See* Exh. H, p. 14, Exh. I, p. 5.
- 18 132. Element ‘d’ of claim 13 requires “at least one web page connected in said system and
- 19 configured to display said hospitality application information”. Rose (Exh. B) discloses
- 20 this limitation at Figs. 5A-22, 7:23-25. Examiner Wu found that Rose discloses
- 21 “application software enabled to configure hospitality data for display on at least one web
- 22 page” at Figs. 5A-22; and 7:23-25. *See* Exh. H, p. 14; Exh. I, p. 5.
- 23 133. Element ‘e’ of claim 13 requires “real time communications control software enabled to
- 24 link and synchronize hospitality application information simultaneously between the
- 25 master database, wireless handheld computing device, web server and web page”. The
- 26 combination of Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Figs.
- 27 4, 23-24, 5A-22, 2:26-29, 6:4-34, 10:59-67, 16:1-17:18, Sirola (Exh. J) at Fig. 1, 2:1-21,
- 28 Hall (Exh. K) at Fig. 1, 3:49-4:37. Examiner Wu found that the combination of Rose,

1 Sirola, and Hall discloses “wherein the system is enabled via application software to  
2 synchronize the at least one hospitality application(s) and its associated data with the data  
3 in a second and different hospitality application in real time between the master database,  
4 the at least one Web server, the at least one wireless computing device and the at least one  
5 web page”. *See* Exh. H, pp. 14-15; Exh. I, pp. 5-6.

6 134. Claim 13 requires “wherein the communications control software is enabled to utilize  
7 parameters from the master database file structure to synchronize the hospitality  
8 application information in real time between the master database, at least one wireless  
9 handheld computing device, at least one web server and at least one web page such that  
10 substantially the same information comprising the hospitality information is capable of  
11 being displayed on the wireless handheld computing device, at least one web page and  
12 other display screens of the synchronized screen, such that the hospitality application  
13 information is synchronized between any connected users”. The combination of Rose,  
14 Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Figs. 4, 23-24, 5A-22,  
15 2:26-29, 6:4-34, 10:59-67, 16:1-17:18, Sirola (Exh. J), Fig. 1, 2:1-21, Hall (Exh. K), Fig.  
16 1, 3:49-4:37.

17 135. Claim 13 requires “wherein the communication control software is enabled to act as a real  
18 time interface between the elements of the system and any applicable communications  
19 protocol”. Rose (Exh. B) discloses this limitation at Figs. 4, 23-24, 5A-22, 2:26-29, 6:4-  
20 34, 10:59-67, 16:1-17:18. Examiner Wu found that Rose discloses “wherein the system is  
21 enabled to perform an automated communications conversion via application software  
22 involving the data associated with the at least one hospitality application” at 7:42-55. *See*  
23 Exh. H, p. 14, Exh. I, p. 5.

24 136. Claim 13 requires “wherein the communications control software is enabled to  
25 automatically and simultaneously configure the hospitality application information for  
26 display on both the wireless handheld computing device and the web page in conformity  
27 with a customized display layout unique to the wireless handheld computing device or the  
28 web page, wherein said customized display layout is compatible with the displayable size



of the handheld computing device display screen or the web page”. The combination of Rose, Sirola and Hall discloses this limitation. *See* Rose (Exh. B) at Figs. 4, 23-24, 5A-22, 2:26-29, 6:4-34, 10:59-67, 16:1-17:18, Sirola (Exh. J) at Fig. 1, 2:1-21, Hall (Exh. K) at Fig. 1, 3:49-4:37.

137. Claim 13 requires “wherein the communications control software is further enabled to automatically format a programmed handheld configuration for display as cascaded sets of linked graphical user interface screens appropriate for a customized display layout of at least two different wireless handheld computing device display sizes in the same connected system”. As addressed previously, Examiner Wu spoke directly to this limitation; *see supra* ¶¶ 124-127. With regards to the limitation “cascaded sets of linked graphical user interface screens”, this limitation is discussed in the ‘077 patent at 6:37-53. Rose (Exh. B) discloses multiple “cascaded sets of linked graphical user interface screens” at Figs. 5A-22. In addition, the combination of Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Abstract, Figs. 3-4, 23-24, 5A-22, 6:4-34, 6:60-64, 7:23-25, 10:59-67, 16:1-17:18; Sirola (Exh. J) at Fig. 1, 1:1-21; Hall (Exh. K) at Fig. 1, 3:49-4:37.

138. Claim 13 requires “wherein a cascaded set of linked graphical user interface screens for a wireless handheld computing device in the system includes a different number of user interface screens from at least one other wireless handheld computing device in the system”. As addressed previously, Examiner Wu spoke directly to this limitation; *see supra* ¶¶ 124-127. In addition, the combination of Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Abstract, Figs. 3-4, 23-24, 5A-22, 6:4-34, 6:60-64, 7:23-25, 10:59-67, 16:1-17:18; Sirola (Exh. J) at Fig. 1, 1:1-21; Hall (Exh. K) at Fig. 1, 3:49-4:37; in particular, *compare* Sirola (Exh. J), Fig. 1 with Hall (Exh. K), Fig. 1.

139. Claim 13 requires “wherein the system is enabled for real time synchronous transmission of the configured hospitality application information to the wireless handheld computing device, the web server and the web page and real time synchronous transmissions of inputs responding to the configured hospitality application information from the wireless



1 handheld computing device, or the web server or the web page.” The combination of  
2 Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Abstract, Figs. 3-4,  
3 23-24, 5A-22, 6:4-34, 6:60-64, 7:23-25, 10:59-67, 16:1-17:18; Sirola (Exh. J) at Fig. 1,  
4 1:1-21; Hall (Exh. K) at Fig. 1, 3:49-4:37;

5 140. On information and belief, McNally became aware of Rose and Sirola sometime before  
6 Fabiano filed the response in the ‘633 application on July 2, 2010.

7 141. On information and belief, Fabiano became aware of Rose and Sirola sometime before  
8 July 2, 2010.

9 142. A period of 635 days, or more than 90 weeks, passed between July 2, 2010 and the  
10 issuance of the ‘077 patent on March 27, 2012. Ameranth could have submitted Rose and  
11 Sirola to the PTO so that they would be of record for the prosecution of the ‘077 patent on  
12 any of those 635 days.

13 143. On information and belief, Fabiano became aware of Hall and the Final Office Action of  
14 February 15, 2011 sometime before March 30, 2011.

15 144. On information and belief, Fabiano or another of Ameranth’s attorney’s made McNally  
16 aware of Hall and the Final Office Action of February 15, 2011 sometime before March  
17 30, 2011.

18 145. On information and belief, Fabiano became aware of the Examiner’s Answer to  
19 Ameranth’s Appeal Brief sometime before August 4, 2011.

20 146. On information and belief, Fabiano or another of Ameranth’s attorneys made McNally  
21 aware of the Examiner’s Answer to Ameranth’s Appeal Brief sometime before August 4,  
22 2011.

23 147. The preamble of claim 13 of the ‘077 patent reads “An information management and real  
24 time synchronous communications system for use with wireless handheld computing  
25 devices and the internet comprising:”. The preamble of claims 77 and 97 of the ‘633  
26 application is identical to the preamble of claim 13 of the ‘077 patent.

27 148. Element (a) of claim 13 of the ‘077 patent reads “a master database connected in said  
28 system and configured to store hospitality application information pursuant to a master

1 database file structure”. Element (a) of claim 77 of the ‘633 application reads “a master  
2 database containing at least one hospitality application(s) and associated data”. Element  
3 (a) of claim 97 of the ‘633 application reads “a master database containing hospitality  
4 applications and associated data”.

5 149. Element (b) of claim 13 of the ‘077 patent reads “at least one wireless handheld  
6 computing device connected in said system and configured to display said hospitality  
7 application information”. Element (b) of claim 77 of the ‘633 application reads  
8 “application software enabled to configure hospitality data for display on the ‘non pc  
9 standard’ display sized screen of at least one wireless handheld computing device in  
10 which the at least one hospitality application is stored”. Element (b) of claim 97 of the  
11 ‘633 application reads “data application software enabled to configure hospitality data for  
12 display on the ‘non pc standard’ display sized screen of at least one wireless handheld  
13 computing device in which the at least one hospitality application is stored”.

14 150. Element (c) of claim 13 of the ‘077 patent reads “at least one web server connected in said  
15 system”. Element (c) of claim 77 of the ‘633 application reads “at least one Web server  
16 enabled by application software to interface with at least one hospitality application and  
17 its associated data”. Element (c) of claim 97 of the ‘633 application reads “at least one  
18 Web server enabled by application software to interface with at least one hospitality  
19 applications and associated data”.

20 151. Element (d) of claim 13 of the ‘077 patent reads “at least one web page connected in said  
21 system and configured to display said hospitality application information”. Element (d) of  
22 claim 77 of the ‘633 application reads “application software enabled to configure  
23 hospitality data for display on at least one web page”.

24 152. Element (e) of claim 13 of the ‘077 patent reads “real time communications control  
25 software enabled to link and synchronize hospitality application information  
26 simultaneously between the master database, wireless handheld computing device, web  
27 server and web page”. The second wherein clause of claim 77 of the ‘633 application  
28 reads “wherein the system is enabled via application software to synchronize the at least

1 one hospitality application(s) and its associated data with the data in a second and  
2 different hospitality application in real time between the master database, the at least one  
3 Web server, the at least one wireless computing device and the at least one web page”.  
4 The first wherein clause of claim 97 of the ‘633 application reads “wherein the system is  
5 enabled by application software to synchronize the at least one hospitality application and  
6 data in real time between the master database, the at least one wireless handheld  
7 computing device, the at least one Web server and the at least one Web page”.

8 153. The second wherein clause of claim 13 of the ‘077 patent reads “wherein the  
9 communications control software is enabled to act as a real time interface between the  
10 elements of the system and any applicable communications protocol”. The third wherein  
11 clause of claim 77 of the ‘633 application reads “wherein the communications control  
12 module is enabled via application software to act as an interface between the at least one  
13 hospitality application(s) and any applicable communications protocol”. The second  
14 wherein clause of claim 97 of the ‘633 application reads “wherein the communications  
15 control module is also enabled via application software to act as an interface between the  
16 at least one hospitality applications and any applicable communications protocol”.

17 154. The claims of the ‘077 patent and the pending claims of the ‘633 application that have  
18 been rejected in view of Rose, Sirola, Hall, and other art contain numerous similar  
19 elements.

20 155. Given the significant similarity between the rejected claims of the ‘633 application and the  
21 claims of the ‘077 patent, Rose, Sirola, and Hall, as well as Examiner Wu’s reasoning in  
22 applying them to the claims pending in the ‘633 application as embodied in the Final  
23 Office Action of February 15, 2011 and the Examiner’s Answer to Ameranth’s Appeal  
24 Brief would have been material to the prosecution of the ‘077 patent, in that the claims of  
25 the ‘077 patent would not have issued if Examiner Brophy had been aware of them.

26 156. Given the significant similarity between the rejected claims of the ‘633 application and the  
27 claims of the ‘077 patent, Rose, Sirola, and Hall, as well as Examiner Wu’s reasoning in  
28 applying them to the claims pending in the ‘633 application as embodied in the Final

1 Office Action of February 15, 2011 and the Examiner's Answer to Ameranth's Appeal  
2 Brief were not cumulative to the prior art of record in the prosecution of the '077 patent.  
3 In particular, no reference or combination of references had been used by another PTO  
4 examiner to reject co-pending claims that were substantially similar to those that issued  
5 with the '077 patent.

6 157. On information and belief, prior to February 6, 2012, Fabiano became aware that Rose,  
7 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
8 pending in the '633 application as embodied in the Final Office Action of February 15,  
9 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
10 to the prosecution of the '077 patent, and this awareness triggered Fabiano's duty to  
11 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
12 the claims pending in the '633 application as embodied in the Final Office  
13 Action of February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to  
14 the PTO under 37 C.F.R. § 1.56.

15 158. On information and belief, prior to February 6, 2012, McNally became aware that Rose,  
16 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
17 pending in the '633 application as embodied in the Final Office Action of February 15,  
18 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
19 to the prosecution of the '077 patent, and this awareness triggered McNally's duty to  
20 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
21 the claims pending in the '633 application as embodied in the Final Office Action of  
22 February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to the PTO  
23 under 37 C.F.R. § 1.56.

24 159. On information and belief, prior to March 27, 2012, Fabiano became aware that Rose,  
25 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
26 pending in the '633 application as embodied in the Final Office Action of February 15,  
27 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
28 to the prosecution of the '077 patent, and this awareness triggered Fabiano's duty to

1 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
2 the claims pending in the '633 application as embodied in the Final Office  
3 Action of February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to  
4 the PTO under 37 C.F.R. § 1.56.

5 160. On information and belief, prior to March 27, 2012, McNally became aware that Rose,  
6 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
7 pending in the '633 application as embodied in the Final Office Action of February 15,  
8 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
9 to the prosecution of the '077 patent, and this awareness triggered McNally's duty to  
10 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
11 the claims pending in the '633 application as embodied in the Final Office Action of  
12 February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to the PTO  
13 under 37 C.F.R. § 1.56.

14 161. Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's  
15 Answer to Ameranth's Appeal Brief are not listed on any information disclosure statement  
16 submitted by Ameranth during prosecution of the '077 patent.

17 162. Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's  
18 Answer to Ameranth's Appeal Brief were not cited by Examiner Brophy during  
19 prosecution of the '077 patent.

20 163. Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's  
21 Answer to Ameranth's Appeal Brief were not disclosed to the PTO during the prosecution  
22 of the '077 patent by Fabiano, McNally, or any other agent of Ameranth.

23 164. On information and belief, Fabiano intentionally withheld Rose, Sirola, Hall, the Final  
24 Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal  
25 Brief from the PTO.

26 165. On information and belief, McNally intentionally withheld Rose, Sirola, Hall, the Final  
27 Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal  
28 Brief from the PTO.

166. On information and belief, Fabiano intentionally withheld Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal Brief from the PTO with the specific intention of deceiving the Patent Office during the prosecution of the '077 patent and thereby breached his duty of good faith and candor in dealing with the PTO under 37 C.F.R. § 1.56.

167. On information and belief, McNally intentionally withheld Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal Brief from the PTO with the specific intention of deceiving the Patent Office during the prosecution of the '077 patent and thereby breached his duty of good faith and candor in dealing with the PTO under 37 C.F.R. § 1.56.

168. The '077 patent would not have issued if Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal Brief had been disclosed to Examiner Brophy. Accordingly, all claims of the '077 patent are unenforceable due to Fabiano and McNally's inequitable conduct during the prosecution of the '077 patent.

#### **Ninth Affirmative Defense**

169. The Complaint fails to adequately set forth allegations sufficient to support its claims of infringement and therefore fails to state a claim under 35 U.S.C. § 271(a),(b), and (c).

#### **Tenth Affirmative Defense**

170. Ameranth's claims for costs are barred, in whole or in part, under 35 U.S.C. § 288.

#### **Eleventh Affirmative Defense**

171. To the extent that Ameranth alleges a theory of divided infringement of multiple actors, GrubHub lacks the requisite direction or control over the activities of other required actors, and therefore, GrubHub cannot be held liable for any joint infringement of any valid and enforceable claim of the '077 patent.

#### **COUNTERCLAIMS**

GrubHub alleges as follows for its Counterclaims against Ameranth.

///

**PARTIES**

172. GrubHub is a Delaware corporation.

173. On information and belief, Ameranth is a Delaware corporation having a principal place of business at 5820 Oberlin Drive, Suite 202, San Diego, California 92121.

**JURISDICTION AND VENUE**

174. Ameranth filed a Complaint against GrubHub in this Court.

175. Ameranth alleges in its Complaint that it is the lawful owner by assignment of all right, title, and interest in and to U.S. Pat. No. 8,146,077 (“the ‘077 patent”).

176. Ameranth alleges in its First Amended Complaint that GrubHub has infringed the ‘077 patent.

177. An actual and justiciable controversy exists between Ameranth and GrubHub.

178. This Court has subject matter jurisdiction over these Counterclaims under 28 U.S.C. § 1338(a), the Patent Laws of the United States, Title 35 of the United States Code, and the Declaratory Judgment Act, 28 §§ U.S.C. 2201 – 2202.

179. Venue is proper in this judicial district pursuant to 28 §§ U.S.C. 1391(b), 1391(c) and 1400.

180. Ameranth has appeared in this lawsuit, is represented by counsel, and has submitted to the jurisdiction of this Court.

**BACKGROUND**

181. Ameranth has a history of litigious behavior, and has previously asserted patents directly related to the ‘077 patent against GrubHub and other Defendants.

a. Cause no. 2:07-CV-00271, in the Eastern District of Texas, asserting U.S. Pat. Nos. 6,384,850, 6,871,325, and 6,982,733.

b. Cause no. 2:10-CV-00294, in the Eastern District of Texas, asserting U.S. Pat. Nos. 6,384,850, 6,871,325, and 6,982,733.

c. Cause no. 3:11-CV-01810 in the Southern District of California, asserting U.S. Pat. Nos. 6,384,850 and 6,871,325.

d. Cause no. 3:12-CV-00739 in the Southern District of California, asserting U.S.

Pat. No. 8,146,077.

182. In cause no. 2:07-CV-00271, a 5-day jury trial was held from September 13, 2010 to September 17, 2010. A jury found that the defendants, Menusoft and CRS, did not infringe the '850 patent, the '325 patent, or the '733 patent. Furthermore, the jury found that Menusoft and CRS had proven, by clear and convincing evidence that all asserted claims of the '850 patent, the '325 patent, and the '733 patent were invalid as anticipated by, and obvious in view of, various prior art references. The Court denied Ameranth's motion for judgment as a matter of law ("JMOL") of no anticipation, nonobviousness, and no invalidity of the asserted claims of the '850 patent, the '325 patent, and the '733 patent.

### **FIRST COUNTERCLAIM**

183. GrubHub incorporates by reference the allegations and answers of all preceding and subsequent paragraphs of these counterclaims as if fully set forth herein.

184. GrubHub does not infringe any valid and enforceable claim of the '077 patent.

185. For example, claims 1-12 of the '077 patent require "[a]n information management and real time synchronous communications system for configuring and transmitting hospitality menus".

186. GrubHub does not make, use, sell, or offer for sale an "ordering system/product/service" that includes "[a]n information management and real time synchronous communications system for configuring and transmitting hospitality menus".

187. For example, claims 1-8 of the '077 patent require "menu configuration software enabled to generate a programmed handheld menu configuration from said master menu for wireless transmission to and programmed for display on a wireless handheld computing device, said programmed handheld menu configuration comprising at least menu categories, menu items and modifiers and wherein the menu configuration software is enabled to generate said programmed handheld menu configuration by utilizing parameters from the master menu file structure defining at least the menu categories, menu items and modifiers of the master menu such that at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are



1           synchronized in real time with analogous information comprising the master menu”.

2       188. GrubHub does not make, use, sell or offer for sale an “ordering system/product/service”  
3       that includes “menu configuration software enabled to generate a programmed handheld  
4       menu configuration from said master menu for wireless transmission to and programmed  
5       for display on a wireless handheld computing device, said programmed handheld menu  
6       configuration comprising at least menu categories, menu items and modifiers and wherein  
7       the menu configuration software is enabled to generate said programmed handheld menu  
8       configuration by utilizing parameters from the master menu file structure defining at least  
9       the menu categories, menu items and modifiers of the master menu such that at least the  
10      menu categories, menu items and modifiers comprising the programmed handheld menu  
11      configuration are synchronized in real time with analogous information comprising the  
12      master menu”.

13      189. For example, claims 9-12 of the ‘077 patent require “a modifier menu capable of being  
14      stored on said data storage device, and menu configuration software enabled to  
15      automatically generate a programmed handheld menu configuration from said master  
16      menu for display on a wireless handheld computing device, said programmed handheld  
17      menu configuration comprising at least menu categories, menu items and modifiers and  
18      wherein the menu configuration software is enabled to generate said programmed  
19      handheld menu configuration by utilizing parameters from the master menu file structure  
20      defining at least the categories and items of the master menu and modifiers from the  
21      modifier menu at least the menu categories, menu items and modifiers comprising the  
22      programmed handheld menu configuration are synchronized in real time with analogous  
23      information comprising the master and modifier menus”.

24      190. GrubHub does not make, use, sell or offer for sale an “ordering system/product/service”  
25      that includes “a modifier menu capable of being stored on said data storage device, and  
26      menu configuration software enabled to automatically generate a programmed handheld  
27      menu configuration from said master menu for display on a wireless handheld computing  
28      device, said programmed handheld menu configuration comprising at least menu

1 categories, menu items and modifiers and wherein the menu configuration software is  
2 enabled to generate said programmed handheld menu configuration by utilizing  
3 parameters from the master menu file structure defining at least the categories and items  
4 of the master menu and modifiers from the modifier menu at least the menu categories,  
5 menu items and modifiers comprising the programmed handheld menu configuration are  
6 synchronized in real time with analogous information comprising the master and modifier  
7 menus”.

8 191. For example, claims 1-12 of the ‘077 patent require “wherein the menu configuration  
9 software is further enabled to generate the programmed handheld menu configuration in  
10 conformity with a customized display layout unique to the wireless handheld computing  
11 device to facilitate user operations with and display of the programmed handheld menu  
12 configuration on the display screen of a handheld graphical user interface integral with the  
13 wireless handheld computing device, wherein said customized display layout is  
14 compatible with the displayable size of the handheld graphical user interface”.

15 192. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
16 that includes “wherein the menu configuration software is further enabled to generate the  
17 programmed handheld menu configuration in conformity with a customized display layout  
18 unique to the wireless handheld computing device to facilitate user operations with and  
19 display of the programmed handheld menu configuration on the display screen of a  
20 handheld graphical user interface integral with the wireless handheld computing device,  
21 wherein said customized display layout is compatible with the displayable size of the  
22 handheld graphical user interface”.

23 193. For example, claims 1-8 require “wherein the programmed handheld menu configuration  
24 is configured by the menu configuration software for display as programmed cascaded  
25 sets of linked graphical user interface screens appropriate for the customized display  
26 layout of the wireless handheld computing device, wherein said programmed cascaded  
27 sets of linked graphical user interface screens for display of the handheld menu  
28 configuration are configured differently from the cascaded sets of linked graphical user

1 interface screens for display of the master menu on said first graphical user interface”.

2 194. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
3 that includes “wherein the programmed handheld menu configuration is configured by the  
4 menu configuration software for display as programmed cascaded sets of linked graphical  
5 user interface screens appropriate for the customized display layout of the wireless  
6 handheld computing device, wherein said programmed cascaded sets of linked graphical  
7 user interface screens for display of the handheld menu configuration are configured  
8 differently from the cascaded sets of linked graphical user interface screens for display of  
9 the master menu on said first graphical user interface”.

10 195. For example, claims 9-12 of the ‘077 patent require “wherein the programmed handheld  
11 menu configuration is configured by the menu configuration software for display as  
12 cascaded sets of linked graphical user interface screens appropriate for the customized  
13 display layout of the wireless handheld computing device, wherein said cascaded sets of  
14 linked graphical user interface screens for display of the programmed handheld menu  
15 configuration are configured differently from the cascaded sets of related graphical user  
16 interface screens for display of the master menu on said first graphical user interface”.

17 196. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
18 that includes “wherein the programmed handheld menu configuration is configured by the  
19 menu configuration software for display as cascaded sets of linked graphical user interface  
20 screens appropriate for the customized display layout of the wireless handheld computing  
21 device, wherein said cascaded sets of linked graphical user interface screens for display of  
22 the programmed handheld menu configuration are configured differently from the  
23 cascaded sets of related graphical user interface screens for display of the master menu on  
24 said first graphical user interface”.

25 197. For example, claims 1-8 of the ‘077 patent require “wherein the system is enabled for real  
26 time synchronous communications to and from the wireless handheld computing device  
27 utilizing the programmed handheld menu configuration including the capability of real  
28 time synchronous transmission of the programmed handheld menu configuration to the

1 wireless handheld computing device and real time synchronous transmissions of  
2 selections made from the handheld menu configuration on the wireless handheld  
3 computing device”.

4 198. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
5 that includes “wherein the system is enabled for real time synchronous communications to  
6 and from the wireless handheld computing device utilizing the programmed handheld  
7 menu configuration including the capability of real time synchronous transmission of the  
8 programmed handheld menu configuration to the wireless handheld computing device and  
9 real time synchronous transmissions of selections made from the handheld menu  
10 configuration on the wireless handheld computing device”.

11 199. For example, claims 9-12 of the ‘077 patent require “wherein the system is enabled for  
12 real time synchronous communications to and from the wireless handheld computing  
13 device utilizing the programmed handheld menu configuration including the capability of  
14 real time synchronous transmission of at least the menu categories, menu items and  
15 modifiers comprising the programmed handheld menu configuration to the wireless  
16 handheld computing device and real time synchronous transmissions of selections made  
17 from the handheld menu configuration on the wireless handheld computing device”.

18 200. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
19 that includes “wherein the system is enabled for real time synchronous communications to  
20 and from the wireless handheld computing device utilizing the programmed handheld  
21 menu configuration including the capability of real time synchronous transmission of at  
22 least the menu categories, menu items and modifiers comprising the programmed  
23 handheld menu configuration to the wireless handheld computing device and real time  
24 synchronous transmissions of selections made from the handheld menu configuration on  
25 the wireless handheld computing device”.

26 201. For example, claims 1-12 of the ‘077 patent require “wherein the system is further enabled  
27 to automatically format the programmed handheld menu configuration for display as  
28 cascaded sets of linked graphical user interface screens appropriate for a customized

1 display layout of at least two different wireless handheld computing device display sizes  
2 in the same connected system”.

3 202. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
4 that includes “wherein the system is further enabled to automatically format the  
5 programmed handheld menu configuration for display as cascaded sets of linked graphical  
6 user interface screens appropriate for a customized display layout of at least two different  
7 wireless handheld computing device display sizes in the same connected system”.

8 203. For example, claims 13-18 of the ‘077 patent require “[a]n information management and  
9 real time synchronous communications system for use with wireless handheld computing  
10 devices and the internet comprising”.

11 204. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
12 that includes “[a]n information management and real time synchronous communications  
13 system for use with wireless handheld computing devices and the internet comprising”.

14 205. For example, claims 13-18 of the ‘077 patent require “real time communications control  
15 software enabled to link and synchronize hospitality application information  
16 simultaneously between the master database, wireless handheld computing device, web  
17 server and web page”.

18 206. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
19 that includes “real time communications control software enabled to link and synchronize  
20 hospitality application information simultaneously between the master database, wireless  
21 handheld computing device, web server and web page”.

22 207. For example, claims 13-18 of the ‘077 patent require “wherein the communications  
23 control software is enabled to utilize parameters from the master database file structure to  
24 synchronize the hospitality application information in real time between the master  
25 database, at least one wireless handheld computing device, at least one web server and at  
26 least one web page such that substantially the same information comprising the hospitality  
27 application information is capable of being displayed on the wireless handheld computing  
28 device, at least one web page and other display screens of the synchronized system, such

- 1           that the hospitality application information is synchronized between any connected users”.
- 2       208. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”
- 3           that includes “wherein the communications control software is enabled to utilize
- 4           parameters from the master database file structure to synchronize the hospitality
- 5           application information in real time between the master database, at least one wireless
- 6           handheld computing device, at least one web server and at least one web page such that
- 7           substantially the same information comprising the hospitality application information is
- 8           capable of being displayed on the wireless handheld computing device, at least one web
- 9           page and other display screens of the synchronized system, such that the hospitality
- 10          application information is synchronized between any connected users”.
- 11       209. For example, claims 13-18 of the ‘077 patent require “wherein the communications
- 12          control software is enabled to act as a real time interface between the elements of the
- 13          system and any applicable communications protocol”.
- 14       210. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”
- 15          that includes “wherein the communications control software is enabled to act as a real
- 16          time interface between the elements of the system and any applicable communications
- 17          protocol”.
- 18       211. For example, claims 13-18 of the ‘077 patent require “wherein the communications
- 19          control software is enabled to automatically and simultaneously configure the hospitality
- 20          application information for display on both the wireless handheld computing device and
- 21          the web page in conformity with a customized display layout unique to the wireless
- 22          handheld computing device or the web page, wherein said customized display layout is
- 23          compatible with the displayable size of the handheld computing device display screen or
- 24          the web page”.
- 25       212. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”
- 26          that includes “wherein the communications control software is enabled to automatically
- 27          and simultaneously configure the hospitality application information for display on both
- 28          the wireless handheld computing device and the web page in conformity with a

1 customized display layout unique to the wireless handheld computing device or the web  
2 page, wherein said customized display layout is compatible with the displayable size of  
3 the handheld computing device display screen or the web page”.

4 213. For example, claims 13-18 of the ‘077 patent require “wherein the communications  
5 control software is further enabled to automatically format a programmed handheld  
6 configuration for display as cascaded sets of linked graphical user interface screens  
7 appropriate for a customized display layout of at least two different wireless handheld  
8 computing device display sizes in the same connected system”.

9 214. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
10 that includes “wherein the communications control software is further enabled to  
11 automatically format a programmed handheld configuration for display as cascaded sets of  
12 linked graphical user interface screens appropriate for a customized display layout of at  
13 least two different wireless handheld computing device display sizes in the same  
14 connected system”.

15 215. For example, claims 13-18 of the ‘077 patent require “wherein the system is enabled for  
16 real time synchronous transmission of the configured hospitality application information  
17 to the wireless handheld computing device, the web server and the web page and real time  
18 synchronous transmissions of inputs responding to the configured hospitality application  
19 information from the wireless handheld computing device, or the web server or the web  
20 page.”

21 216. GrubHub does not make, use, sell, or offer for sale an “ordering system/product/service”  
22 that includes “wherein the system is enabled for real time synchronous transmission of the  
23 configured hospitality application information to the wireless handheld computing device,  
24 the web server and the web page and real time synchronous transmissions of inputs  
25 responding to the configured hospitality application information from the wireless  
26 handheld computing device, or the web server or the web page.”

27 217. GrubHub has not infringed and is not infringing, either literally or under the Doctrine of  
28 Equivalents, directly or indirectly, by inducement or contribution, any valid and



1 enforceable claim of the '077 patent.

2 218. As GrubHub has not infringed and is not infringing any valid and enforceable claim of the  
3 '077 patent, GrubHub has not willfully infringed and is not willfully infringing any valid  
4 and enforceable claim of the '077 patent.

### 5 **SECOND COUNTERCLAIM**

6 219. GrubHub incorporates by reference the allegations and answers of all preceding and  
7 subsequent paragraphs of these counterclaims as if fully set forth herein.

8 220. The asserted claims of the '077 patent are taught in one or more single prior references  
9 and/or by a single prior art system, and are, therefore, invalid as anticipated.

10 221. For example, under the constructions that Ameranth is apparently taking in this case, each  
11 and every element of the claims of the '077 patent are taught by U.S. Pat. No. 5,845,263  
12 ("Camaisa"), issued December 1, 1998, and titled Visual Ordering System. A true and  
13 correct copy of Camaisa is attached hereto as Exhibit A. Camaisa is prior art to the '077  
14 patent.

15 222. For example, under the constructions that Ameranth is apparently taking in this case, each  
16 and every element of the asserted claims of the '077 patent are taught by U.S. Pat. No.  
17 7,069,228 ("Rose"), issued June 27, 2006 and titled "Apparatus and Method for an  
18 Internet Based Computer Reservation Booking System". A true and correct copy of Rose  
19 is attached hereto as Exhibit B. Rose is prior art to the '077 patent.

20 223. Ameranth has accused Allmenus.com and Campusfood.com of infringing the '077 patent.

21 224. Allmenus.com and Campusfood.com use a common ordering system ("the Campusfood  
22 Ordering System").

23 225. The Campusfood Ordering System was designed and implemented prior to September 2,  
24 1997. On September 2, 1997, the Campusfood Ordering System took its first public  
25 orders, and it has been in continuous use since then. A brochure discussing the  
26 Campusfood Ordering System is attached as Exhibit C.

27 226. Under the constructions put forth by Ameranth in the First Menusoft Action, each and  
28 every element of the asserted claims of the '077 patent was present in the Campusfood



Ordering System prior to the earliest priority date of the '077 patent.

227. Therefore, the claims of the '077 patent are invalid as anticipated under 35 U.S.C. § 102.

### **THIRD COUNTERCLAIM**

228. GrubHub incorporates by reference the allegations and answers of all preceding and subsequent paragraphs of these counterclaims as if fully set forth herein.

229. The claims of the '077 patent are invalid as one of ordinary skill in the art would have found them obvious at the time of alleged invention. *See* 35 U.S.C. § 103.

230. The “TransPad” is prior art to the ‘077 patent. A true and correct copy of a publication describing the TransPad is attached hereto as Exhibit D.

231. The claims of the '077 patent would have been obvious to one of ordinary skill in the art, for example, through a combination of one or more of TransPad, Camaisa, Rose, the Campusfood Ordering System, or other prior art references.

232. Therefore, the asserted claims of the '077 patent are invalid as obvious under 35 U.S.C. § 103.

#### **FOURTH COUNTERCLAIM**

233. GrubHub incorporates by reference the allegations and answers of all preceding and subsequent paragraphs of these counterclaims as if fully set forth herein.

234. The claims of the '077 patent are invalid as they have not complied with 35 U.S.C. § 112.

235. For example, the term “real-time” appears in the specification of the ‘077 patent in three places, outside of the claims: Col. 2, Line 27; Col. 5, Line 11; and Col. 12, Line 34. In each location that “real-time” is mentioned, it is within a sentence that reads similarly to the following: “Such features would include fast and automatic synchronization between a central database and multiple handheld devices, synchronization and communication between a World Wide Web (“Web”) server and multiple handheld devices, a well-defined application program interface (“API”) that enables third parties such as point of sale (“POS”) companies, affinity program companies and internet content providers to fully integrate with computerized hospitality applications, real-time communication over the internet with direct connections or regular model dialup connections and support for

1 batch processing that can be done periodically throughout the day to keep multiple sites in  
2 synch with the central database.”

3 236. The specification of the ‘077 patent does not teach how real time synchronization of  
4 menus or some other hospitality information would be maintained between a wireless  
5 handheld device and a master menu or master database, which is required by all claims.

6 237. For example, claims 1-12 of the ‘077 patent require “[a]n information management and  
7 real time synchronous communications system for configuring and transmitting hospitality  
8 menus”.

9 238. The written description of the ‘077 patent does not support “[a]n information management  
10 and real time synchronous communications system for configuring and transmitting  
11 hospitality menus”.

12 239. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary  
13 skill in the art to implement “[a]n information management and real time synchronous  
14 communications system for configuring and transmitting hospitality menus”.

15 240. For example, claims 1-8 of the ‘077 patent require that “the menu configuration software  
16 is enabled to generate said programmed handheld menu configuration by utilizing  
17 parameters from the master menu file structure defining at least the menu categories,  
18 menu items and modifiers of the master menu such that at least the menu categories, menu  
19 items and modifiers comprising the programmed handheld menu configuration are  
20 synchronized in real time with analogous information comprising the master menu”.

21 241. The written description of the ‘077 patent does not support “the menu configuration  
22 software is enabled to generate said programmed handheld menu configuration by  
23 utilizing parameters from the master menu file structure defining at least the menu  
24 categories, menu items and modifiers of the master menu such that at least the menu  
25 categories, menu items and modifiers comprising the programmed handheld menu  
26 configuration are synchronized in real time with analogous information comprising the  
27 master menu”.

28 242. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary

1 skill in the art to implement “the menu configuration software is enabled to generate said  
2 programmed handheld menu configuration by utilizing parameters from the master menu  
3 file structure defining at least the menu categories, menu items and modifiers of the  
4 master menu such that at least the menu categories, menu items and modifiers comprising  
5 the programmed handheld menu configuration are synchronized in real time with  
6 analogous information comprising the master menu”.

7 243. For example, claim 9-12 of the ‘077 patent require “the menu configuration software is  
8 enabled to generate said programmed handheld menu configuration by utilizing  
9 parameters from the master menu file structure defining at least the categories and items  
10 of the master menu and modifiers from the modifier menu at least the menu categories,  
11 menu items and modifiers comprising the programmed handheld menu configuration are  
12 synchronized in real time with analogous information comprising the master and modifier  
13 menus”.

14 244. The written description of the ‘077 patent does not support “the menu configuration  
15 software is enabled to generate said programmed handheld menu configuration by  
16 utilizing parameters from the master menu file structure defining at least the categories  
17 and items of the master menu and modifiers from the modifier menu at least the menu  
18 categories, menu items and modifiers comprising the programmed handheld menu  
19 configuration are synchronized in real time with analogous information comprising the  
20 master and modifier menus”.

21 245. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary  
22 skill in the art to implement “the menu configuration software is enabled to generate said  
23 programmed handheld menu configuration by utilizing parameters from the master menu  
24 file structure defining at least the categories and items of the master menu and modifiers  
25 from the modifier menu at least the menu categories, menu items and modifiers  
26 comprising the programmed handheld menu configuration are synchronized in real time  
27 with analogous information comprising the master and modifier menus”.

28 246. For example, claims 13-18 of the ‘077 patent require “[a]n information management and

1 real time synchronous communications system for use with wireless handheld computing  
2 devices and the internet”.

3 247. The written description of the ‘077 patent does not support “[a]n information management  
4 and real time synchronous communications system for use with wireless handheld  
5 computing devices and the internet”.

6 248. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary  
7 skill in the art to implement “[a]n information management and real time synchronous  
8 communications system for use with wireless handheld computing devices and the  
9 internet”.

10 249. For example, claims 13-18 of the ‘077 patent require “real time communications software  
11 enabled to link and synchronize hospitality application information simultaneously  
12 between the master database, wireless handheld computing device, web server and web  
13 page”.

14 250. The written description of the ‘077 patent does not support “real time communications  
15 software enabled to link and synchronize hospitality application information  
16 simultaneously between the master database, wireless handheld computing device, web  
17 server and web page”.

18 251. The disclosure of the ‘077 patent taken as a whole does not enable a person of ordinary  
19 skill in the art to implement “real time communications software enabled to link and  
20 synchronize hospitality application information simultaneously between the master  
21 database, wireless handheld computing device, web server and web page”.

22 252. For example, claims 1-18 all require a “real time synchronous communications system”.  
23 A person of ordinary skill in the art would find the phrase “real time synchronous  
24 communications system” insolubly ambiguous, and therefore, all claims of the ‘077 patent  
25 are indefinite.

26 253. Therefore, all claims of the ‘077 patent are invalid for failing to comply with 35 U.S.C. §  
27 112.

28 ///

**FIFTH COUNTERCLAIM**

254. GrubHub incorporates by reference the allegations and answers of all preceding and subsequent paragraphs of these counterclaims as if fully set forth herein.

255. All claims of the '077 patent are unenforceable due to inequitable conduct during the prosecution of the '077 patent by Fabiano, who acted as prosecution counsel for Ameranth before the PTO, and Keith McNally ("McNally"), a named inventor and officer of Ameranth.

256. On February 2, 2010, McNally, who was then Chief Executive Officer of Ameranth, executed a power of attorney allowing Fabiano to represent Ameranth before the PTO within the prosecution of the '077 patent.

257. During the prosecution of the '077 patent McNally executed no fewer than four (4) declarations and participated in multiple interviews between Ameranth and the PTO. Accordingly, on information and belief, McNally was significantly involved in the prosecution of the '077 patent.

258. On information and belief, McNally stands to benefit financially from any licensing fees or other revenue generated by the '077 patent.

259. Fabiano was retained by Ameranth to represent them in the prosecution of the '077 patent and the litigation of the '077 patent, and was significantly involved in the prosecution of the '077 patent. On information and belief, Fabiano stands to benefit financially from any licensing fees or other revenue generated by the '077 patent.

260. On February 2, 2012, Examiner Matthew Brophy ("Brophy") issued a notice of allowance after entering an earlier Examiner's amendment, Ameranth paid the issue fee on February 6, 2012, and the '077 patent actually issued on March 27, 2012. Examiner Brophy primarily handled the examination of the '077 patent.

261. On July 26, 2005 U.S. Pat. Appl. 11/190,633 ("the '633 application") was filed on behalf of Ameranth as a continuation-in-part of the application that matured into the '077 patent. The specification of the '077 patent is substantially similar to that of the '633 application.

262. Examination of the '633 application has primarily been handled by Examiner Rutao Wu

1 (“Wu”).

2 263. In an office action mailed on January 7, 2010, Examiner Wu finally rejected all claims  
3 then pending of the ‘633 application as obvious over the combination of U.S. Pat. Nos.  
4 7,069,228 (“Rose”) and 6,415,138 (“Sirola”). The January 7, 2010 office action is  
5 attached as Exhibit E. Sirola is attached hereto as Exhibit J.

6 264. Examiner Wu essentially argued that the web server of Rose served up hospitality  
7 information in accordance with the claimed elements, and that it would have been obvious  
8 to use the smart phone of Sirola to display the hospitality information served by Rose’s  
9 web server using a web browser integrated into the smart phone. *See* Exh. E pp. 2-4, 6-7.

10 265. On information and belief, Fabiano or another attorney of Ameranth discussed the January  
11 7, 2010 final rejection with McNally and made him aware of the combination of Rose and  
12 Sirola.

13 266. On July 2, 2010, McNally, who was then President of Ameranth, executed a power of  
14 attorney allowing Fabiano to prosecute the ‘633 application. On the same day Fabiano  
15 filed a response to the rejection of all of Ameranth’s claims then pending in the ‘633  
16 application. The July 2, 2010 response added a claim element to claims 77 and 97 that  
17 required that hospitality information be displayed on “non PC standard display sizes”  
18 including display on the wireless handheld computing device. The July 2, 2010 response  
19 presented detailed arguments attempting to distinguish Ameranth’s alleged invention from  
20 Rose, Sirola, and the other cited art. Ameranth’s July 2, 2010 response is attached hereto  
21 as Exhibit F.

22 267. Despite Ameranth’s arguments, Examiner Wu continued to reject all of Ameranth’s  
23 claims in an office action dated October 5, 2010, which continued to rely on the  
24 combination of Rose and Sirola. All of Ameranth’s arguments were rejected by Examiner  
25 Wu in the October 5, 2010 office action, which is attached hereto as Exhibit G.

26 268. On October 26, 2010, Fabiano filed a response to the October 5, 2010 rejection. The  
27 October 26, 2010 response presented additional detailed arguments attempting to  
28 distinguish Ameranth’s alleged invention from Rose, Sirola and the other cited art.

- 1 269. On information and belief, on November 16, 2010 Fabiano held a telephonic interview  
2 with Examiner Wu during which Rose, Sirola and other prior art references were  
3 discussed.
- 4 270. On December 8, 2010 Fabiano filed a supplemental response presenting additional  
5 arguments attempting to distinguish Ameranth's alleged invention from Rose, Sirola and  
6 the other cited art.
- 7 271. On February 15, 2011 Examiner Wu issued a final rejection of all of pending claims of the  
8 '633 application. The February 15, 2011 rejection maintained Rose as the primary  
9 reference, and maintained the combination with Sirola. A new combination with U.S. Pat.  
10 No. 6,356,543 ("Hall") was added as well. Hall is attached hereto as Exhibit K. In the  
11 February 15, 2011 rejection, which is attached hereto as Exhibit H, Examiner Wu set forth  
12 detailed rebuttals to Ameranth's arguments. *See* Exh. H, pp. 3 – 13.
- 13 272. Ameranth appealed Examiner Wu's Decision. Ameranth filed its Appeal Brief on March  
14 30, 2011. Examiner Wu filed an Examiner's Answer on June 6, 2011, attached hereto as  
15 Exhibit I. Ameranth filed its reply brief on August 4, 2011. As of the date of this answer,  
16 this appeal is still pending. None of the briefing of this appeal was submitted to the Patent  
17 Office with regards to the prosecution of the '077 patent.
- 18 273. Hall discloses a phone that can be used to download applications. It would have been  
19 obvious to a person of skill in the art at the time of the alleged invention to extend Hall to  
20 allow the download of an application allowing a web service interface with the web  
21 applications of Rose.
- 22 274. The reasons for allowance for the '077 patent reads as follows: "none of the prior art of  
23 record, alone or in reasonable combination, teach the limitations: wherein the system is  
24 further enabled to automatically format the programmed handheld menu configuration for  
25 display as cascaded sets of linked graphical user interface screens appropriate for a  
26 customized display layout of at least two different wireless handheld computing device  
27 display sizes in the same connected system, and wherein a cascaded set of linked  
28 graphical user interface screens for a wireless handheld computing device in the system

1 includes a different number of user interface screens from at least one other wireless  
2 handheld computing device in the system. When combined with the other limitations of  
3 claim 103, 118 and 122. Specifically in these independent claims, the menu generation  
4 software and hospitality applications, in the context of the claimed system, which  
5 automatically create programmed handheld displayed as cascaded sets of graphical user  
6 interface screens for at least two different sizes and including at least two cascaded sets of  
7 GUIs with disparate screen counts in not found in the prior art as of the priority date  
8 September 21, 1999. No prior art of record, nor any combination [] teaches all limitations  
9 of the newly amended independent claims.”

10 275. The combination of Rose, Sirola, and Hall speaks directly to the limitations that caused  
11 Examiner Brophy to issue the ‘077 patent. In particular, Rose discloses that it serves up  
12 hospitality content using a web server as a series of related hospitality web pages. *See*  
13 Exh. B, Figs. 5A – 22; Exh. H, pp. 2-13, 13-15; Exh I, pp. 4-5, 13-29. The content of  
14 Rose, can be displayed by any conventional web browser. *See* Exh. H, pp. 2-13, 13-15.  
15 Sirola and Hall both disclose wireless handheld computing devices that can be used to  
16 display the web pages served by the web server of Rose. *See* Exh. J, 2:1-11, and Exh. K,  
17 Abstract. Both Sirola and Hall disclose separate wireless handheld computing devices  
18 that can be used to display hospitality information. *See* Exh. H, pp. 12-13, 15; Exh. J, Fig.  
19 1; Exh. K, Fig. 1. Based on the individual screen sizes and resolutions of the phones of  
20 Sirola and Hall, the web pages will appear different from one another. *Compare* Exh. J,  
21 Fig. 1 *with* Exh. K, Fig. 1. Accordingly, the combination of Rose, Sirola, and Hall makes  
22 obvious the very limitations that Ameranth utilized to gain allowance. *See* Exh. H, pp. 3-  
23 5, 11-15; Exh. I, pp. 5-6, 16-21; *see especially* p. 19-20.

24 276. In fact, the combination of Rose, Sirola, and Hall makes obvious the entirety of at least  
25 claim 13 of the ‘077 patent. Accordingly, the ‘077 patent would not have issued if  
26 Fabiano and McNally had fulfilled their duty to disclose these references, as well as the  
27 Final Office Action of February 15, 2011 and the Examiner’s Answer to Examiner  
28 Brophy.



1 277. The analysis of Examiner Wu, as embodied by the Final Office Action of February 15,  
2 2011 (Exh. H), and the Examiner's Answer to Ameranth's Appeal Brief (Exh. I), shows  
3 Examiner Wu's detailed theory as to how to apply Rose, Sirola, and Hall to claims that are  
4 extremely similar to those that issued in the '077 patent. Examiner Wu's analysis of the  
5 claim elements of claims 77 and 97 requiring the display of hospitality data on "non PC  
6 standard display sizes" speaks directly to how Examiner Brophy could have applied Rose,  
7 Sirola, and Hall to reject at least claim 13 of the '077 patent.

8 278. The preamble of claim 13 requires "[a]n information management and real time  
9 synchronous communications system for use with wireless handheld computing devices  
10 and the internet comprising:". This limitation can be found in Rose (Exh. B) at the  
11 Abstract and 2:24-35.

12 279. Element 'a' of claim 13 requires "a master database connected in said system and  
13 configured to store hospitality application information pursuant to a master database file  
14 structure". This limitation is found in Rose (Exh. B) at Fig. 4, 6:44-55. Examiner Wu  
15 found the similar element "a master database containing at least one hospitality  
16 application(s) and associated data" in Rose (Exh. B) at 6:44-55; *see also* Exh. H, p. 14;  
17 Exh. I, p. 5.

18 280. Element 'b' of claim 13 requires "at least one wireless handheld computing device  
19 connected in said system and configured to display said hospitality application  
20 information". The combination of Rose and Sirola discloses this limitation. *See* Rose  
21 (Exh. B), Figs. 5A-22, 7:23-25; Sirola (Exh. J), Fig. 1, 2:1-21. Examiner Wu found that  
22 the combination of Rose and Sirola discloses "application software enabled to configure  
23 hospitality data for display on the 'non pc standard' display sized screen of at least one  
24 wireless handheld computing device in which the at least one hospitality application is  
25 stored". In particular, Examiner Wu found that Rose disclosed "application software  
26 enabled to configure hospitality data for display on at least one web page" at Figs. 5A-22  
27 and 7:23-25, and that Sirola discloses a smart phone device (which is a wireless handheld  
28 computing device with non pc standard display) that is capable of displaying web data at

1 2:1-21. *See* Exh. H, pp. 14-15, and Exh. I, pp. 5-6.

2 281. Element ‘c’ of claim 13 requires “at least one web server connected in said system”. Rose  
3 (Exh. B) discloses this limitation at Fig. 3, 6:60-64. Examiner Wu found that Rose (Exh.  
4 B) discloses “at least one web server enabled to interface with at least one hospitality  
5 applications and its associated data” at 6:60-64. *See* Exh. H, p. 14, Exh. I, p. 5.

6 282. Element ‘d’ of claim 13 requires “at least one web page connected in said system and  
7 configured to display said hospitality application information”. Rose (Exh. B) discloses  
8 this limitation at Figs. 5A-22, 7:23-25. Examiner Wu found that Rose (Exh. B) discloses  
9 “application software enabled to configure hospitality data for display on at least one web  
10 page” at Figs. 5A-22; and 7:23-25. *See* Exh. H, p. 14; Exh. I, p. 5.

11 283. Element ‘e’ of claim 13 requires “real time communications control software enabled to  
12 link and synchronize hospitality application information simultaneously between the  
13 master database, wireless handheld computing device, web server and web page”. The  
14 combination of Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Figs.  
15 4, 23-24, 5A-22, 2:26-29, 6:4-34, 10:59-67, 16:1-17:18, Sirola (Exh. J) at Fig. 1, 2:1-21,  
16 Hall (Exh. K) at Fig. 1, 3:49-4:37. Examiner Wu found that the combination of Rose,  
17 Sirola, and Hall discloses “wherein the system is enabled via application software to  
18 synchronize the at least one hospitality application(s) and its associated data with the data  
19 in a second and different hospitality application in real time between the master database,  
20 the at least one Web server, the at least one wireless computing device and the at least one  
21 web page”. *See* Exh. H, pp. 14-15; Exh. I, pp. 5-6.

22 284. Claim 13 requires “wherein the communications control software is enabled to utilize  
23 parameters from the master database file structure to synchronize the hospitality  
24 application information in real time between the master database, at least one wireless  
25 handheld computing device, at least one web server and at least one web page such that  
26 substantially the same information comprising the hospitality information is capable of  
27 being displayed on the wireless handheld computing device, at least one web page and  
28 other display screens of the synchronized screen, such that the hospitality application

information is synchronized between any connected users”. The combination of Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Figs. 4, 23-24, 5A-22, 2:26-29, 6:4-34, 10:59-67, 16:1-17:18, Sirola (Exh. J), Fig. 1, 2:1-21, Hall (Exh. K), Fig. 1, 3:49-4:37.

285. Claim 13 requires “wherein the communication control software is enabled to act as a real time interface between the elements of the system and any applicable communications protocol”. Rose (Exh. B) discloses this limitation at Figs. 4, 23-24, 5A-22, 2:26-29, 6:4-34, 10:59-67, 16:1-17:18. Examiner Wu found that Rose discloses “wherein the system is enabled to perform an automated communications conversion via application software involving the data associated with the at least one hospitality application” at 7:42-55. *See* Exh. H, p. 14, Exh. I, p. 5.

286. Claim 13 requires “wherein the communications control software is enabled to automatically and simultaneously configure the hospitality application information for display on both the wireless handheld computing device and the web page in conformity with a customized display layout unique to the wireless handheld computing device or the web page, wherein said customized display layout is compatible with the displayable size of the handheld computing device display screen or the web page”. The combination of Rose, Sirola and Hall discloses this limitation. *See* Rose (Exh. B) at Figs. 4, 23-24, 5A-22, 2:26-29, 6:4-34, 10:59-67, 16:1-17:18, Sirola (Exh. J) at Fig. 1, 2:1-21, Hall (Exh. K) at Fig. 1, 3:49-4:37.

287. Claim 13 requires “wherein the communications control software is further enabled to automatically format a programmed handheld configuration for display as cascaded sets of linked graphical user interface screens appropriate for a customized display layout of at least two different wireless handheld computing device display sizes in the same connected system”. As addressed previously, Examiner Wu spoke directly to this limitation; *see supra* ¶¶ 274-277. With regards to the limitation “cascaded sets of linked graphical user interface screens”, this limitation is discussed in the ‘077 patent at 6:37-53. Rose (Exh. B) discloses multiple “cascaded sets of linked graphical user interface screens”

1 at Figs. 5A-22. In addition, the combination of Rose, Sirola, and Hall discloses this  
2 limitation. *See* Rose (Exh. B) at Abstract, Figs. 3-4, 23-24, 5A-22, 6:4-34, 6:60-64, 7:23-  
3 25, 10:59-67, 16:1-17:18; Sirola (Exh. J) at Fig. 1, 1:1-21; Hall (Exh. K) at Fig. 1, 3:49-  
4 4:37.

5 288. Claim 13 requires “wherein a cascaded set of linked graphical user interface screens for a  
6 wireless handheld computing device in the system includes a different number of user  
7 interface screens from at least one other wireless handheld computing device in the  
8 system”. As addressed previously, Examiner Wu spoke directly to this limitation; *see*  
9 *supra* ¶¶ 274-277. In addition, the combination of Rose, Sirola, and Hall discloses this  
10 limitation. *See* Rose (Exh. B) at Abstract, Figs. 3-4, 23-24, 5A-22, 6:4-34, 6:60-64, 7:23-  
11 25, 10:59-67, 16:1-17:18; Sirola (Exh. J) at Fig. 1, 1:1-21; Hall (Exh. K) at Fig. 1, 3:49-  
12 4:37; in particular, *compare* Sirola (Exh. J), Fig. 1 with Hall (Exh. K), Fig. 1.

13 289. Claim 13 requires “wherein the system is enabled for real time synchronous transmission  
14 of the configured hospitality application information to the wireless handheld computing  
15 device, the web server and the web page and real time synchronous transmissions of  
16 inputs responding to the configured hospitality application information from the wireless  
17 handheld computing device, or the web server or the web page.” The combination of  
18 Rose, Sirola, and Hall discloses this limitation. *See* Rose (Exh. B) at Abstract, Figs. 3-4,  
19 23-24, 5A-22, 6:4-34, 6:60-64, 7:23-25, 10:59-67, 16:1-17:18; Sirola (Exh. J) at Fig. 1,  
20 1:1-21; Hall (Exh. K) at Fig. 1, 3:49-4:37;

21 290. McNally became aware of Rose and Sirola sometime before Fabiano filed the response in  
22 the ‘633 application on July 2, 2010.

23 291. On information and belief, Fabiano became aware of Rose and Sirola sometime before  
24 July 2, 2010.

25 292. A period of 635 days, or more than 90 weeks, passed between July 2, 2010 and the  
26 issuance of the ‘077 patent on March 27, 2012. Fabiano could have submitted Rose and  
27 Sirola to the PTO so that they would be of record for the prosecution of the ‘077 patent on  
28 any of those 635 days.

1 293. On information and belief, Fabiano became aware of Hall and the Final Office Action of  
2 February 15, 2011 sometime before March 30, 2011.

3 294. On information and belief, Fabiano or another of Ameranth's attorney's made McNally  
4 aware of Hall and the Final Office Action of February 15, 2011 sometime before March  
5 30, 2011.

6 295. On information and belief, Fabiano became aware of the Examiner's Answer to  
7 Ameranth's Appeal Brief sometime before August 4, 2011.

8 296. On information and belief, Fabiano or another of Ameranth's attorneys made McNally  
9 aware of the Examiner's Answer to Ameranth's Appeal Brief sometime before August 4,  
10 2011.

11 297. The preamble of claim 13 of the '077 patent reads "An information management and real  
12 time synchronous communications system for use with wireless handheld computing  
13 devices and the internet comprising:". The preamble of claims 77 and 97 of the '633  
14 application is identical to the preamble of claim 13 of the '077 patent.

15 298. Element (a) of claim 13 of the '077 patent reads "a master database connected in said  
16 system and configured to store hospitality application information pursuant to a master  
17 database file structure". Element (a) of claim 77 of the '633 application reads "a master  
18 database containing at least one hospitality application(s) and associated data". Element  
19 (a) of claim 97 of the '633 application reads "a master database containing hospitality  
20 applications and associated data".

21 299. Element (b) of claim 13 of the '077 patent reads "at least one wireless handheld  
22 computing device connected in said system and configured to display said hospitality  
23 application information". Element (b) of claim 77 of the '633 application reads  
24 "application software enabled to configure hospitality data for display on the 'non pc  
25 standard' display sized screen of at least one wireless handheld computing device in  
26 which the at least one hospitality application is stored". Element (b) of claim 97 of the  
27 '633 application reads "data application software enabled to configure hospitality data for  
28 display on the 'non pc standard' display sized screen of at least one wireless handheld

1 computing device in which the at least one hospitality application is stored”.

2 300. Element (c) of claim 13 of the ‘077 patent reads “at least one web server connected in said  
3 system”. Element (c) of claim 77 of the ‘633 application reads “at least one Web server  
4 enabled by application software to interface with at least one hospitality application and  
5 its associated data”. Element (c) of claim 97 of the ‘633 application reads “at least one  
6 Web server enabled by application software to interface with at least one hospitality  
7 applications and associated data”.

8 301. Element (d) of claim 13 of the ‘077 patent reads “at least one web page connected in said  
9 system and configured to display said hospitality application information”. Element (d) of  
10 claim 77 of the ‘633 application reads “application software enabled to configure  
11 hospitality data for display on at least one web page”.

12 302. Element (e) of claim 13 of the ‘077 patent reads “real time communications control  
13 software enabled to link and synchronize hospitality application information  
14 simultaneously between the master database, wireless handheld computing device, web  
15 server and web page”. The second wherein clause of claim 77 of the ‘633 application  
16 reads “wherein the system is enabled via application software to synchronize the at least  
17 one hospitality application(s) and its associated data with the data in a second and  
18 different hospitality application in real time between the master database, the at least one  
19 Web server, the at least one wireless computing device and the at least one web page”.  
20 The first wherein clause of claim 97 of the ‘633 application reads “wherein the system is  
21 enabled by application software to synchronize the at least one hospitality application and  
22 data in real time between the master database, the at least one wireless handheld  
23 computing device, the at least one Web server and the at least one Web page”.

24 303. The second wherein clause of claim 13 of the ‘077 patent reads “wherein the  
25 communications control software is enabled to act as a real time interface between the  
26 elements of the system and any applicable communications protocol”. The third wherein  
27 clause of claim 77 of the ‘633 application reads “wherein the communications control  
28 module is enabled via application software to act as an interface between the at least one

1           hospitality application(s) and any applicable communications protocol”. The second  
2           wherein clause of claim 97 of the ‘633 application reads “wherein the communications  
3           control module is also enabled via application software to act as an interface between the  
4           at least one hospitality applications and any applicable communications protocol”.

5       304. The claims of the ‘077 patent and the pending claims of the ‘633 application that have  
6           been rejected in view of Rose, Sirola, Hall, and other art contain numerous similar  
7           elements.

8       305. Given the significant similarity between the rejected claims of the ‘633 application and the  
9           claims of the ‘077 patent, Rose, Sirola, and Hall, as well as Examiner Wu’s reasoning in  
10          applying them to the claims pending in the ‘633 application as embodied in the Final  
11          Office Action of February 15, 2011 and the Examiner’s Answer to Ameranth’s Appeal  
12          Brief would have been material to the prosecution of the ‘077 patent, in that the claims of  
13          the ‘077 patent would not have issued if Examiner Brophy had been aware of them.

14       306. Given the significant similarity between the rejected claims of the ‘633 application and the  
15           claims of the ‘077 patent, Rose, Sirola, and Hall, as well as Examiner Wu’s reasoning in  
16           applying them to the claims pending in the ‘633 application as embodied in the Final  
17           Office Action of February 15, 2011 and the Examiner’s Answer to Ameranth’s Appeal  
18           Brief were not cumulative to the prior art of record in the prosecution of the ‘077 patent.  
19           In particular, no reference or combination of references had been used by another PTO  
20           examiner to reject co-pending claims that were substantially similar to those that issued  
21           with the ‘077 patent.

22       307. On information and belief, prior to February 6, 2012, Fabiano became aware that Rose,  
23           Sirola, and Hall, as well as Examiner Wu’s reasoning in applying them to the claims  
24           pending in the ‘633 application as embodied in the Final Office Action of February 15,  
25           2011 and the Examiner’s Answer to Ameranth’s Appeal Brief would have been material  
26           to the prosecution of the ‘077 patent, and this awareness triggered Fabiano’s duty to  
27           disclose Rose, Sirola, and Hall, as well as Examiner Wu’s reasoning in applying them to  
28           the claims pending in the ‘633 application as embodied in the Final Office



1 Action of February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to  
2 the PTO under 37 C.F.R. § 1.56.

3 308. On information and belief, prior to February 6, 2012, McNally became aware that Rose,  
4 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
5 pending in the '633 application as embodied in the Final Office Action of February 15,  
6 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
7 to the prosecution of the '077 patent, and this awareness triggered McNally's duty to  
8 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
9 the claims pending in the '633 application as embodied in the Final Office Action of  
10 February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to the PTO  
11 under 37 C.F.R. § 1.56.

12 309. On information and belief, prior to March 27, 2012, Fabiano became aware that Rose,  
13 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
14 pending in the '633 application as embodied in the Final Office Action of February 15,  
15 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
16 to the prosecution of the '077 patent, and this awareness triggered Fabiano's duty to  
17 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
18 the claims pending in the '633 application as embodied in the Final Office  
19 Action of February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to  
20 the PTO under 37 C.F.R. § 1.56.

21 310. On information and belief, prior to March 27, 2012, McNally became aware that Rose,  
22 Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to the claims  
23 pending in the '633 application as embodied in the Final Office Action of February 15,  
24 2011 and the Examiner's Answer to Ameranth's Appeal Brief would have been material  
25 to the prosecution of the '077 patent, and this awareness triggered McNally's duty to  
26 disclose Rose, Sirola, and Hall, as well as Examiner Wu's reasoning in applying them to  
27 the claims pending in the '633 application as embodied in the Final Office Action of  
28 February 15, 2011 and the Examiner's Answer to Ameranth's Appeal Brief to the PTO



1 under 37 C.F.R. § 1.56.

2 311. Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's  
3 Answer to Ameranth's Appeal Brief are not listed on any information disclosure statement  
4 submitted by Ameranth during prosecution of the '077 patent.

5 312. Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's  
6 Answer to Ameranth's Appeal Brief were not cited by Examiner Brophy during  
7 prosecution of the '077 patent.

8 313. Rose, Sirola, Hall, the Final Office Action of February 15, 2011, and the Examiner's  
9 Answer to Ameranth's Appeal Brief were not disclosed to the PTO during the prosecution  
10 of the '077 patent by Fabiano, McNally, or any other agent of Ameranth.

11 314. On information and belief, Fabiano intentionally withheld Rose, Sirola, Hall, the Final  
12 Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal  
13 Brief from the PTO.

14 315. On information and belief, McNally intentionally withheld Rose, Sirola, Hall, the Final  
15 Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal  
16 Brief from the PTO.

17 316. On information and belief, Fabiano intentionally withheld Rose, Sirola, Hall, the Final  
18 Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal  
19 Brief from the PTO with the specific intention of deceiving the Patent Office during the  
20 prosecution of the '077 patent and thereby breached his duty of good faith and candor in  
21 dealing with the PTO under 37 C.F.R. § 1.56.

22 317. On information and belief, McNally intentionally withheld Rose, Sirola, Hall, the Final  
23 Office Action of February 15, 2011, and the Examiner's Answer to Ameranth's Appeal  
24 Brief from the PTO with the specific intention of deceiving the Patent Office during the  
25 prosecution of the '077 patent and thereby breached his duty of good faith and candor in  
26 dealing with the PTO under 37 C.F.R. § 1.56.

27 318. The '077 patent would not have issued if Rose, Sirola, Hall, the Final Office Action of  
28 February 15, 2011, and the Examiner's Answer to Ameranth's Appeal Brief had been

disclosed to Examiner Brophy. Accordingly, all claims of the '077 patent are unenforceable due to Fabiano and McNally's inequitable conduct during the prosecution of the '077 patent.

### **TRIAL BY JURY**

319. GrubHub demands a trial by jury on all issues so triable

### **PRAYER FOR RELIEF**

320. GrubHub, reserving its right to amend its pleading to add additional defenses, affirmative defenses, and counterclaims if warranted by discovery in this lawsuit, requests the following relief:

- a. A judgment declaring that GrubHub has not infringed any valid and enforceable claim of the '077 patent.
- b. A judgment declaring that all claims of the '077 patent are invalid as anticipated by the prior art.
- c. A judgment declaring that all claims of the '077 patent are obvious in view of the prior art.
- d. A judgment declaring that all claims of the '077 patent are invalid for failure to comply with 35 U.S.C. § 112.
- e. A judgment declaring that Ameranth's Complaint for Patent Infringement is dismissed with prejudice, and that Ameranth take nothing by its Complaint.
- f. An injunction enjoining Ameranth, any other party claiming rights through Ameranth, and any other party in privity with Ameranth, from charging infringement of the '077 patent against GrubHub and anyone in privity with GrubHub, including its successors, assigns, agents, and customers.
- g. A judgment declaring that the '077 patent is unenforceable due to inequitable conduct.
- h. A judgment declaring that this is an exceptional case pursuant to 35 U.S.C. § 285 and an award to GrubHub of its reasonable attorney's fees and costs of suit pursuant to 35 U.S.C. §§ 284, 285, and all other applicable statutes, rules, and law.

///

1 i. All such other relief that this Court may deem just and proper.  
2

3 DATED: August 2, 2012

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